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# Brief on Appeal – Revised per Notification of Non-Compliant Brief

## IN THE UNITED STATES PATENT OFFICE

In re application of David Huddleston  
Serial No. 10/765,501  
Filed 1/26/2004  
“Flared Opening Drawstring closure Cell  
Phone Carrier”

Before the Board of Appeals  
On Appeal

### Amended Brief on appeal From Final Rejection

Completed on Sunday 8/20/2006, and to be sent by Express Mail on Monday 8/21/2006  
- thus complying with the 1 month time limit following applicant’s Notification of  
Non-Compliant Brief on 7/19/2006

The requisite small entity fee was paid for by a check for \$250 (check # 1009), which  
accompanied the original Appeal Brief.

Hon. Commissioner of Patents,  
Washington, D.C.

Sir,

This is a brief on appeal from final rejection of all active claims in application  
Serial No. 10/765,501 Filed 1/26/2004, by David E. Huddleston.

Respectfully,  
David E. Huddleston  
President, IMHUDCO, LLC

**(i) Real party in interest**

The real party in interest is IMHUDCO, LLC. Patent application 10/765,501 was assigned to IMHUDCO, LLC. David E. Huddleston is the president of IMHUDCO, LLC, and he is herein writing on behalf of IMHUDCO, LLC.

**(ii) Related appeals and interferences**

The following court decision is referenced in the brief in support of this appeal: United States Court of Appeals for the Federal Circuit in regard to 04-1152 Teleflex, Incorporated and Technology Holding Company v. KRS International, Co. , 1/6/2006. This court decision will hereafter be referred to as USCAFC-0401152.

**(iii) Status of claims**

Claim 1 is an independent claim which has been amended from its original wording, and it is being appealed.

Claim 2 is a dependent claim of claim 1 which has been amended from its original wording, and it is being appealed. Applicant has been made aware, not by the examiner, that his use of "A" rather than "The" might be viewed as poor practice in the writing of dependent claims. It is possible that this is part of the basis of the examiner's objections to the wording of claims. If so it was incumbent on the examiner to make such objections more specific, per MPEP § 2173.02, which states "the examiner should suggest improved language to the applicant" and "an analysis as to why the phrase(s) used in the claim is vague and indefinite should be included in the office action". This comment applies to all the dependent claims (2-10 and 12-20) listed below.

Claim 3 is a dependent claim of claim 1 which has been amended from its original wording, and it is being appealed.

Claim 4 is a dependent claim of claim 1 which has been amended from its original wording, and it is being appealed.

Claim 5 is a dependent claim of claim 1 which has been amended from its original wording, and it is being appealed.

Claim 6 is a dependent claim of claim 1. It has been canceled, and it is not being appealed.

Claim 7 is a dependent claim of claim 1 which has been amended from its original wording, and it is being appealed.

Claim 8 is a dependent claim of claim 1. It has been canceled, and it is not being appealed.

Claim 9 is a dependent claim of claim 1 which has been amended from its original wording, and it is being appealed.

Claim 10 is a dependent claim of claim 1. It has been canceled, and it is not being appealed.

Claim 11 is an independent claim which has been amended from its original wording, and it is being appealed.

Claim 12 is a dependent claim of claim 11 which has been amended from its original wording, and it is being appealed. This claim was mistakenly amended to refer to claim 10 rather than claim 11. The applicant mistakenly did this when claim 6 was canceled, thinking that the claims should then be renumbered. This same clarification applies to claims 13-20 below.

Claim 13 is a dependent claim of claim 11 which has been amended from its original wording, and it is being appealed.

Claim 14 is a dependent claim of claim 11 which has been amended from its original wording, and it is being appealed.

Claim 15 is a dependent claim of claim 11 which has been amended from its original wording, and it is being appealed.

Claim 16 is a dependent claim of claim 11. It has been canceled, and it is not being appealed.

Claim 17 is a dependent claim of claim 11 which has been amended from its original wording, and it is being appealed.

Claim 18 is a dependent claim of claim 11. It has been canceled, and it is not being appealed.

Claim 19 is a dependent claim of claim 11 which has been amended from its original wording, and it is being appealed.

Claim 20 is a dependent claim of claim 11. It has been canceled, and it is not being appealed.

**(iv) Status of amendments**

No amendments have been filed subsequent to final rejection.

**(v) Summary of claimed subject matter**

Applicant's invention is a cell phone carrier designed to be appropriate and fashionable in multiple social settings and situations, which will be comfortable and convenient to use and carry, and which will be low cost to produce. This cell phone carrier design also facilitates easy imprinting of indicia, which coupled with the low cost of production will readily enable usage as an advertising vehicle in large scale promotions.

There are two basic embodiments of the invention claimed, along with variations of each embodiment. The first embodiment is illustrated in FIG. 1 of the application, which shows a cell phone carrier designed for convenience of removal and insertion of the cell phone, for convenience of carrying, and due to the ease and economy of manufacture is well-suited as an advertising medium. The key features of this embodiment are contained in Claim 1, and are comprised of a functionally appropriate shape, and attached handles for quick opening of the cell phone carrier.

Figures 2A through 2I illustrate a typical manufacturing process of the first basic embodiment of the invention, whereby the result is a cell phone carrier which is symmetrical about its vertical axis. Figures 3A through 3C illustrate a typical manufacturing process of the first basic embodiment of the invention, whereby the result is a cell phone carrier which is not symmetrical about its vertical axis.

The second basic embodiment closely resembles the first, with the exception that the flared opening of the cell phone holder is achieved by using a stretchable material for the cell phone holder, thus achieving the functionally necessary flared opening to the cell phone carrier by stretching the opening of the carrier. A typical manufacturing process of this embodiment is illustrated in figures 4A through 4K.

An embodiment of the invention which an identification badge holder (65) on the outside of the cell phone carrier is illustrated in FIG. 5K.

The embodiments utilizing indicia (63), and clipping means (53) are illustrated in FIG. 1.

**(vi) Grounds of rejection to be reviewed on appeal**

1. The examiner disallowed several disclosure documents which the applicant had found through Internet searches, on the basis that publication dates and other identifiers of traditional printed materials was required. The applicant submits that the examiner here disregards USPTO rules and procedures.
2. The examiner rejected all claims on the basis of the wording of the claims. The applicant submits that the examiner here disregards USPTO rules and procedures.
3. The examiner rejected claims 1, 2 and 4, asserting the obviousness of these claims based on prior art of Lindheim (213,580) and Tabler (665, 942). The applicant submits that the examiner fails to show motivation to combine features from the prior art.
4. The examiner rejected claim 3, asserting the obviousness of this claim based on prior art of Lindheim (213,580), Tabler (665, 942), and Kahl (2005/0072698). The applicant submits that the examiner fails to show motivation to combine features from the prior art.
5. The examiner rejected claims 5 and 9, asserting the obviousness of these claims based on prior art of Lindheim (213,580), Tabler (665, 942), and Furlow (4,974,709). The applicant submits that the examiner fails to show motivation to combine features from the prior art.
6. The examiner rejected claims 11-16 and 19, asserting the obviousness of these claims based on prior art of Lindheim (213,580), Tabler (665, 942), Furlow (4,974,709), and Janssen (4,215,629). The applicant submits that the examiner fails to show motivation to combine features from the prior art.
7. The examiner rejected claims 7 and 17, asserting the obviousness of these claims based on prior art of Lindheim (213,580), Tabler (665, 942), Furlow (4,974,709), Janssen (4,215,629), and Pollak (3,225,806). The applicant submits that the examiner fails to show motivation to combine features from the prior art.
8. The examiner confounds independent claim 11 with independent claim 1 "since there is no requirement for stretching the opening of the bag to form the flared opening as argued by the Applicant"
9. The examiner asserts that "The handles of Tabler are placed near the opening as indicated by the claim.
10. The examiner made various procedural errors in executing the Final Action.

**(vii) Argument**

1. In disallowing Internet-based disclosure documents, the examiner disregarded USPTO rules and procedures. The examiner's position is in contradiction to various Patent Office rules in MPEP § 2128, as follows – "An electronic publication, including an on-line database or Internet publication, is considered to

be a printed publication within the meaning of 35 U.S.C 102(a) and (b) provided the publication was accessible to persons concerned with the art to which the document relates.” Other areas of this document elaborate on the wide range of disclosure documents that are admissible. The applicant provided such proof of the existence of these publications as it was possible for him to do so. These constituted printouts of the web pages declared, along with Universal Resource Locators (URL) for those sites. These Internet-based disclosure documents also speak to the non-obviousness of applicant’s invention, because applicant was unable to find the exact embodiments of his invention using Internet searches. It is also to be supposed that the examiner undertook no Internet searches. In many instances the examiner proposes the obviousness of combinations of features of prior. Failure to find Internet-based prior art which exactly match the embodiments of the applicant’s invention, would go far to show the lack of motivation to combine the prior art cited by the examiner.

2. In rejecting claims based upon their wording, the examiner disregarded USPTO rules and procedures. The entire basis of the rejection of all claims in this paragraph is the supposed precision of the wording of the claims for applicant’s invention. Per MPEP § 2173.01, “... a claim may not be solely rejected because of the type of language used to define the subject matter for which patent protection is sought”. While the applicant has here shown that this rejection of his claims is unwarranted according to Patent Office rules, he further maintains that the language of the claims meets the requirements of MPEP § 2173.02 as to this language being clear enough to “... a person of ordinary skill in the art ...”. The examiner here criticizes the usage of terms such as opened, bag, and stiff wire-like means. In a previous office action the examiner criticized the usage of mouth, for which the term opening was substituted. The applicant maintains that these terms are sufficiently clear to one skilled in the art. Some of the citations given by the examiner liberally use similar terminology, as follows:  
US 4,215,629 – page 7 lines 16 – 18 “... a drawstring member 303, typically formed of wire or a similar, relatively stiff material”  
US 4,215,629, US 4,974,709, US 3,225,806, US 213,580 – numerous usages of the terms such as bag and mouth, for which there is no lack of clarity for one skilled in the art concerned.
3. In rejecting claims 1, 2 and 4, the examiner merely asserts the obviousness of combining features from the prior art references given. He provides no motivation to combine these features and to use the result as a cell phone carrier. The basis of the examiner’s rejections here is that the applicant’s claims are anticipated by a supposedly obvious combination of Lindheim (213,580) and Tabler (665, 942). However, referencing USCAFC-0401152, the applicant maintains that the examiner does not show “The reason, suggestion, or motivation to combine the prior art references ... ‘ that the court found necessary. Cell phones were unheard of when Lindheim and Tabler were awarded their patents, so there is no teaching towards using an embodiment of either or of a combination of the two as a cell phone holder. There is no teaching in Lindheim which suggests adding handles to the tobacco pouch design. There is no teaching in Tabler which suggests using a flared opening for a mail bag. The examiner

provides no motivation for anyone to combine features of a tobacco pouch, and a mail bag, and then to use the result as a cell phone holder. To quote USCAFC-0401152 (page 6) – “... (explaining that the temptation to engage in impermissible hindsight is especially strong with seemingly simple mechanical inventions).

This is because combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability-the essence of hindsight”. The applicant maintains that the reasons for rejection given by the examiner in this paragraph are overcome because the examiner is employing 20-20 hindsight to make the combination of features in the applicant’s claim *appear* obvious. The applicant also maintains that the Internet-based disclosure document he supplied, speak to the nonobviousness of his invention. These disclosures illustrate that the combinations of features proposed by the examiner are indeed not obvious.

4. In rejecting claim 3, the examiner again asserts non-obviousness based upon combination of features from multiple prior art referenced. The arguments given in paragraph 4 above, based upon USCAFC-0401152 apply to the objections here raised by the examiner. The examiner further makes the mistake of dispositioning this dependent claim without reference to the associated independent claim. As such his objections must overcome the combination of features from Lindheim (213,580), Tabler (665,942), and Kahl (2005/0072698). Further while Kahl at least does relate to a cell phone application, it has significant differences from that of the applicant. These are in the usage of a heat-shrinkable material and lack of usage of a draw-string closure. Applicant’s claim of novelty and non-obviousness relates to the use of indicia on the “carrier of Claim 1”, not on a cell phone carrier of any kind, or on a bag of any kind.
5. The same arguments based upon USCAFC-0401152, apply to the objections here raised by the examiner. Claims 5 and 9 are dependent claims of Claim 1, so the examiner must here argue that a combination of Lindheim (213, 580), Tabler (665,942), and Furlow (4,974,709) anticipate the applicant’s claims. As elsewhere the examiner is using the applicant’s invention as a “... as a blueprint for piecing together the prior art to defeat patentability ...”, which has been found to be unallowable by the court decision USCAFC-0401152. As such the applicant maintains that the examiner’s rejections contained in this paragraph are overcome.
6. The examiner here introduces a new citation – Janssen (4,215,629) - supposedly justified by the applicant’s amendment. Presumably the amendment of Claim 11, per the examiner’s objection to some of the terminology used in that claim, warrants the new citation. The amendment of Claim 11 introduces no new concepts necessitating a new prior art citation. However, here as elsewhere, the examiner cites the combination of multiple pieces of prior art as the basis for his rejection. Examining Claim 11, which is the sole independent claim in this group, the examiner proposes that the combination of features from three pieces of prior art anticipates Claim 11. This is in combination with a usage for the result as a cell phone carrier, which is not taught or anticipated by any of the three. This confounding of features from three separate pieces of prior art, none of which

reference each other, and for use in a completely new application stretches the limits of the practice found inadmissible by USCAFC-0401152. This is further compounded when the examiner lumps the various dependent claims of Claim 11 into this paragraph. Along with the combination of features from three pieces of prior art (for the novel usage as a cell phone carrier) needed to reject independent claim 11, the examiner must now argue that combinations of features from 4 pieces of prior art are needed to overcome the dependent claims 12-16 and 19. The applicant maintains that it is not obvious to combine features from three or more pieces of prior art, usually entailing additional implied innovations such as a novel usage for the application as a cell phone holder. The applicant further maintains that the proposed combinations of features would not appear obvious without the applicant's "...blueprint for piecing together the prior art...". Further support of the novelty and non-obviousness of the features of applicant's invention embodied in claims 11-19, are provided in the Internet references refused by the examiner. These references attest that the applicant could locate no other prior art which exactly anticipates the applicant's invention, but which the examiner still argues is an obvious combination of features of other prior art.

7. As elsewhere, the examiner here confounds claims 7 and 17, which are dependent claims of the two unconnected independent claims 1 and 11. For the examiner's argument regarding claim 7, he must argue the combination of features from Lindheim (213,580), Tabler (665,942), and Pollak (3,225,806). This supposedly obvious combination of features is then to be used for an application unforeseen for any of the prior art cited. A further stretch of the referenced feature of Pollack is required to modify the fully enclosed pocket shown in FIG. 1 of Pollack to one with a window or clear panel for use as an Identification Badge holder. Similarly to overcome claim 17, the examiner must propose the combination of features from Lindheim (213, 580), Janssen (4,215,629), and Pollack (3,225,806). Again this combination of features to be adapted to the application of a cell phone carrier, which was not taught or foreseen by any of the cited prior art. The same objection, with regard to modifying Pollack's closed pocket applies here. The applicant maintains that the examiner's citation of combinations of features from three and four pieces of prior art, along with further innovations such as transforming a closed pocket to one with an aperture or clear panel, and the usage of the final result for an application not taught or foreseen by any of the cited prior – namely as a cell phone carrier – clearly amounts to a novel and non-obvious combination. In keeping with the court's findings in USCAFC-0401152, the applicant maintains that all the examiners rejections in this paragraph are overcome.
8. The use of a stretchable material, coupled with stretching that material to achieve a flared opening is the basis claim 11, and as such is a requirement.
9. The applicant submits that this statement is not warranted based on per Tabler's drawing and specifications. Tabler states that "handles are usually attached to the body portion of the bag"(page 1 line 96), and depicts the handles attached to the side of the bag in Fig. 3.
10. These are procedural errors in contradiction of MPEP § 706.07, such as introducing new prior art citations without sufficient justification, and a failure to

establish "...a clear issue ... between the examiner and applicant." While it is understood that under MPEP § 706.07(c) these procedural errors are not of themselves grounds for appeal, they do speak to the overly expeditious manner in which the applicant's application for patent was handled. The examiner's comment with respect to amendment necessitating a new citation are a non-sequiter in the context of this paragraph. The subject of this paragraph presumably relates to the adaptation of the feature of handles in Tabler (665,942). This subject bears no relation to the new citation – Janssen (4,215,629) – which introduced prior art relating to use of a stiff wire-like means. The examiner's confusion on the correct context for this comment speak to the issues of establishing "...a clear issue ... between the examiner and applicant.", and to the correctness of executing a final action after introducing this unwarranted new citation.

**(viii) Claims appendix**

1. (CURRENTLY AMENDED) A cell phone carrier comprising:
  - a. A suitably sized bag, which is of flexible material, which is assembled from one or more panels of material or is woven or shaped into a single unit, and which has a flared opening when the bag is fully opened. ~~mouth in the relaxed and unsecured state.~~
  - b. A means to serve as a drawstring for closing the bag of 1.a..
    - a. A means to mate a drawstring with the edge of the opening ~~mouth~~ of the bag of 1.a., either continuously or at discrete points along the circumference of the opening of the bag ~~mouth~~.
    - b. One or more handles attached at or near the edge of the opening of the bag 1.a., and which are positioned to facilitate quick opening of the bag of 1.a..
2. (ORIGINAL) A carrier as in claim 1 whose dimensions have been re-scaled to accommodate items larger or smaller than cell phones.
3. (ORIGINAL) A carrier as in claim 1 which has been embellished with indicia.
4. (CURRENTLY AMENDED) A carrier as in claim 1 which is adapted ~~used~~ to carry eyeglasses or sunglasses, or any of a variety of small electronic items including ~~such as~~ calculators, palmtop or handheld computers, ~~or~~ personal organizers and contact managers.



5. (CURRENTLY AMENDED) A carrier as in claim 1 which has an attaching means affixed to the end of the drawstring means, which enables the user to attach the carrier to their clothing, or such as to a belt or belt loop.
6. (CANCELED)
7. (CURRENTLY AMENDED) A carrier as in claim 1 which also incorporates an external identification card holder, and which permits the identification card to be kept visible.
8. (CANCELED)
9. (CURRENTLY AMENDED) A carrier as in claim 1, which has a belt or strap formed from or affixed to the drawstring means.
10. (CANCELED)
11. (CURRENTLY AMENDED) A cell phone carrier comprising:
  - a. A suitably sized bag of flexible and stretchable material, which is assembled from one or more panels of material or is woven or shaped as a single unit.
  - b. A means to mate a stiff wire-like draw-wire means with the edge of the opening mouth of the bag, either continuously or at discrete points along the circumference of the opening mouth.
  - c. An stiff wire-like incompressible means to be mated with the edge of the opening of the bag to serve as a draw-wire for closing the bag, and which will ~~to~~ shape the mouth of the bag while it is open.
  - d. A clasping clipping means assembled onto the stiff wire-like incompressible draw-wire means, and also attached to the carrier bag at the edge of the opening mouth of the bag, such that the bag can be opened by pulling the clasping clipping means along the stiff wire-like drawstring means and then engaging the clasping means ~~it~~ to maintain a flared shape to the opening mouth.
12. (CURRENTLY AMENDED) A carrier as in claim 1044 whose dimensions have been re-scaled to accommodate items larger or smaller than cell phones.
13. (CURRENTLY AMENDED) A carrier as in claim 1044 which has been embellished with indicia.

14. (CURRENTLY AMENDED) A carrier as in claim ~~1044~~ which is adapted ~~used~~ to carry eyeglasses or sunglasses, or any of a variety of small electronic items including ~~such as~~ calculators, palmtop or handheld computers, ~~or~~ personal organizers and contact managers.
15. (CURRENTLY AMENDED) A carrier as in claim ~~1044~~ which has an attaching means affixed to the end of the ~~stiff wire-like drawstring~~ means, which enables the user to attach the carrier to their clothing, or ~~such as~~ to a belt or belt loop.
16. (CURRENTLY AMENDED) A carrier as in claim ~~1044~~ which also incorporates one or more handles attached at or near the edge of the opening of the bag, and which are positioned to facilitate quick opening of the bag.
17. (CURRENTLY AMENDED) A carrier as in claim ~~1044~~ which also incorporates an external identification card holder, and which permits the identification card to be kept visible.
18. (CANCELED)
19. (CURRENTLY AMENDED) A carrier as in claim ~~1044~~ which has a belt or strap formed from or affixed to the ~~stiff wire-like drawstring~~ means.
20. (CANCELED).

**(ix) Evidence appendix**

1. Copy of patent application 10/765,501 by David E. Huddleston filed on 1/26/2004 for "FLARED-OPENING DRAWSTRING CLOSURE CELL PHONE CARRIER"
2. A copy of the Notification of Non-Compliant Appeal sent on 7/19/06.
3. Copy of Final Action in regard to 10/765,501 executed by examiner Luan K. Bui on 1/11/2006
4. Copies of Internet Printed Publications listed in applicant's disclosure of Non Patent Literature Documents
5. Copy of MPEP § 2128 regarding Patent Office rules on what constitutes a "Printed Publication" suitable for disclosure
6. Copy of MPEP § 2173.01 and MPEP § 2173.02 regarding claim terminology and precision
7. Copy of MPEP § 706.7 regarding final rejection of claims.
8. Copies of applicable prior art citations by the examiner:
  - a. Copy of 213,580 by Minnie Lindheim filed 3/25/1879
  - b. Copy of 665,942 by J.N. Tabler filed 1/15/1901
  - c. Copy of US 2005/0072698 by Leo Kahl filed 9/2/2003
  - d. Copy of 4,974,709 by Thelma L. Furlow and Lisa M. Furlow filed 12/4/1990
  - e. Copy of 3,225,806 by Victor S. Pollak, et.al filed 12/28/1965
  - f. Copy of 4,215,629 by Alexander P. Janssen filed 8/5/1980



# UNITED STATES PATENT AND TRADEMARK OFFICE

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR    | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-------------------------|---------------------|------------------|
| 10/765,501      | 01/26/2004  | David Eugene Huddleston | DEH1001             | 2563             |

7590 07/19/2006

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DATE MAILED: 07/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

BEST AVAILABLE COPY

**Notification of Non-Compliant Appeal Brief  
(37 CFR 41.37)**

Application No.

107700.001

Examiner

Leah Bul

Applicant(s)

HUDDLESTON, DAVID EUGENE

Art Unit

3728

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 19 June 2000 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.**

1. ☒ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☒ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☐ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☐ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☒ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☒ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☐ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☐ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☒ Other (including any explanation in support of the above items):

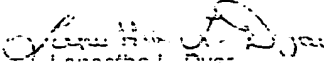
1. Must identify the real party by name or corporation.

2. Must include status of all claims and identify the appealed claims.

6. Each ground of rejection should be argued under it's own heading.

7. A clear concise explanation of each independent claim is not present and should refer to the specification by page and line number or by paragraph number.

10. Please refer to the Appeal Brief 37 CFR 41.37.

  
Anastasia I. Dyer  
Patent Appeal Specialist

# Office Action Summary

Application No.

10/765,501

Applicant(s)

HUDDLESTON, DAVID EUGENE

Examiner

Luan K. Bui

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5,7,9,11-17 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,7,9,11-17 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/29/04.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

***Information Disclosure Statement***

1. The information disclosure statement filed 3/29/2004 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because most of the non patent literature documents do not include title of the article, date (the article was printed on ...), number of page (s) .

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-5, 7, 9, 11-17 and 19 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrases "1.a." (two places) and "1.a.," (two places), "opened.," "bag." in claim 1 and "unit.," "opening." "open." in claim 11 are incomplete and indefinite. The phrases "a drawstring" in claim 1, line 7 and "a stiff wire-like means" in claim 11, line, 8 is double recitation of line 5. Claims 12-17 and 19 depend from the canceled claim 10. In claims 7 and 17, the phrase "permits the identification card to be kept visible" is confusion and indefinite because it has no clear meaning as to how to be kept visible?

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1, 2 and 4 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Lindheim (213,580) in view of Tabler (665,942). Lindheim discloses a carrier (A) comprising a suitably sized bag of flexible material formed from one or more panels of material and the bag having a flared opening when the bag is fully opened (Figure 2), a means to serve and mate as a drawstring (C, D) for closing and opening the bag (Figures 1-3). The bag of Lindheim is capable of holding a cell phone. Lindheim also discloses the other claimed limitations except for one or more handles being attached near the edge of the opening. Tabler teaches a bag (A) comprises one or more handles (23) for handling the bag. It would have been obvious to one having ordinary skill in the art in view of Tabler to modify the bag of Lindheim so the bag includes one or more handles attached near the edge of the opening for handling the bag such as for carrying the bag. The handle of the bag of Lindheim as modified is capable for using to open the bag. As to claims 2 and 4, the bag of Lindheim is capable to hold any of a variety of small electronic items as claimed.

7. Claim 3 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of Kahl (2005/0072698). Lindheim as



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modified further fails to show the carrier comprises indicia. Kahl teaches a bag having a graphic indicia (Figure 4 and claim 7). It would have been obvious to one having ordinary skill in the art in view of Kahl to modify the bag of Lindheim as modified so it includes indicia for decorative purposes.

8. Claims 5 and 9 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the reference as applied to claim 1 above, and further in view of Furlow et al. (4,974,709; hereinafter Furlow'709). Lindheim as modified further fails to show an attaching means being affixed to the end of the drawstring means. Furlow'709 shows a bag (10) having an attaching means (87, 89) affixed to the end of the straps (86, 88) (Figure 5) and clasping means (44) assembled onto the drawstring (Figure 4). It would have been obvious to one having ordinary skill in the art in view of Furlow'709 to modify the bag of Lindheim as modified so the end of the drawstring means includes an attaching means to facilitate attaching the bag to another object or folding the bag for storage. The bag of Lindheim as modified with the attaching means and the attaching means is capable for attaching the bag to the user's clothing such as a belt.

9. Claims 11-16 and 19 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the reference as applied to claim 5 above, and further in view of Janssen (4,215,629). Lindheim further fails to show the carrier comprises a stiff wire like means in lieu of the drawstring and a clasping means being assembled onto the stiff wire-like means. Janssen teaches a bag (282) having an opening (308) and a stiff wire-like means (303) (column 7, lines 16-23) for closing the opening or to maintain the opening in an open position (Figure 7). It would have

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been obvious to one having ordinary skill in the art in view of Furlow'709 and Janssen to modify the bag of Lindheim so the drawstring comprises a stiff wire-like means as taught by Janssen to maintain the shape of the opening in an open position and to facilitate inserting and/or removing items from the bag and the bag further includes a clasping means as taught by Furlow'709 for better securing the opening. As to claim 13, see claim 3 above. As to claim 14, see claim 4 above. As to claim 15, see claim 5 above. As to claim 16, see claim 1 above. As to claim 19, see claim 9 above.

10. Claims 7 and 17 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1 and 11 above, and further in view of Pollak et al. (3,225,806; hereinafter Pollak'806). Lindheim further fails to show the bag comprises an external holder. Pollak'806 shows the bag (20) having an external holder (23, 24) (Figure 1). It would have been obvious to one having ordinary skill in the art in view of Pollak'806 to modify the bag of Lindheim so it includes an external holder to facilitate holding an additional item such as an identification card. It would have been obvious to one having ordinary skill in the art in view of Lindheim as modified so the external holder formed from a transparent material to allow visual access to the contents within the holder since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

***Response to Arguments***

Applicant's arguments with respect to 12/1/2005 have been considered but are deemed to be moot in view of the new grounds of rejection.

1. The internet information sources may be permitted if applicant provides all the information as indicated above under Information Disclosure Statement section.

5. & 6. Applicant indicates that "Lindheim teaches away from the idea of the flared opening of the bag facilitating removal of items from the bag" is noted. This is not persuasive because the flared opening of Lindheim is also allowing for insertion of a user's hand into the bag to remove items from the bag which is considered equivalent to facilitating removal of items from the bag.

7. – 9. As a point of clarification, none of the rejection under 103(a) anticipate the claims of the instant invention. Lindheim and Kahl are related to a field of bag and Kahl is relied upon for nothing more than the bag comprises an indicia.

10. The flared opening as recited in claim 11 is read on the flared opening of Lindheim since there is no requirement for stretching the opening of the bag to form the flared opening as argued by Applicant.

11. The handles of Tabler are placed near the edge of the opening as indicated by the claim.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is 571-272-4552. The examiner can normally be reached on 8:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. **The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for Formal papers and After Final communications.**

Art Unit: 3728

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lkb  
January 11, 2006



Luan K. Bui  
Primary Examiner  
Art Unit 3728

|                                   |                                       |  |             |
|-----------------------------------|---------------------------------------|--|-------------|
| <b>Notice of References Cited</b> | Application/Control No.<br>10/765,501 | Applicant(s)/Patent Under<br>Reexamination<br>HUDDLESTON, DAVID EUGENE |             |
|                                   | Examiner<br>Luan K. Bui               | Art Unit<br>3728   | Page 1 of 1 |

**U.S. PATENT DOCUMENTS**

| * |   | Document Number<br>Country Code-Number-Kind Code | Date<br>MM-YYYY | Name                  | Classification |
|---|---|--|-----------------|-----------------------|----------------|
| * | A | US-4,215,629                                     | 08-1980         | Janssen, Alexander P. | 99/403         |
|   | B | US-  |                 |                       |                |
|   | C | US-  |                 |                       |                |
|   | D | US-  |                 |                       |                |
|   | E | US-  |                 |                       |                |
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**NON-PATENT DOCUMENTS**

| * |   | Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages) |
|---|---|---|
|   | U |   |
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\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).) -  
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|------------------------|---------------------|
| Application Number     | 10/765501           |
| Filing Date            | 1/26/2004           |
| First Named Inventor   | David E. Huddleston |
| Art Unit               |                     |
| Examiner Name          |                     |
| Attorney Docket Number | DEH1001             |

Sheet 2 of 3

## U. S. PATENT DOCUMENTS

| U. S. PATENT DOCUMENTS |             |                              |                                |  |   |
|------------------------|-------------|------------------------------|--------------------------------|--|---|
| Examiner<br>Initials*  | Cite<br>No. | Document Number              | Publication Date<br>MM-DD-YYYY | Name of Patentee or<br>Applicant of Cited Document | Pages, Columns, Lines, Where<br>Relevant Passages or Relevant<br>Figures Appear |
|                        |             | Number-Kind Code* (if known) |                                |  |   |
| LJB                    | 20          | US- 6,006,969                | 12/28/1999                     | Dong-Joo Kim                                       | various   |
|                        | 21          | US- 6,076,789                | 6/20/2000                      | Barry D. Jackson                                   | various   |
|                        | 22          | US- 6,651,854 B1             | 11/25/2003                     | Marvin LaCoste                                     | various   |
|                        | 23          | US- 2,377,311                | 6/5/1945                       | Hugh P. Campbell                                   | various   |
|                        | 24          | US- 6,564,838 B1             | 5/20/2003                      | Halsey Cruikshank                                  | various   |
|                        | 25          | US- 4,608,283                | 8/26/1986                      | Ruth A. White                                      | various   |
|                        | 26          | US- 5,996,999                | 12/7/1999                      | Avis Joyce Casely                                  | various   |
|                        | 27          | US- 4,974,761                | 12/4/1990                      | Irma J. Luque                                      | various   |
|                        | 28          | US- 2,253,688                | 8/26/1941                      | Edwin D. Collins                                   | various   |
|                        | 29          | US- 665,942                  | 1/15/1901                      | Jasper Newton Tabler                               | various   |
|                        | 30          | US- 595,685                  | 12/21/1897                     | Abraham Abraham                                    | various   |
|                        | 31          | US- D139,335                 | 11/7/1944                      | Eric de Kolb                                       | various   |
|                        | 32          | US- D115,541                 | 7/4/1939                       | Moe J. Cohen                                       | various   |
|                        | 33          | US- 5,351,868                | 10/4/1994                      | Robert J. Beletsky                                 | various   |
|                        | 34          | US- D382,996                 | 9/2/1997                       | David Kopel  | various   |
|                        | 35          | US- D416,132                 | 11/9/1999                      | Joe Sung-Ho Tan                                    | various   |
|                        | 36          | US- 5,511,704                | 4/30/1996                      | John E. Linderer                                   | various   |
|                        | 37          | US- 5,833,100                | 11/10/1998                     | Dong-Joo Kim                                       | various   |
|                        | 38          | US- D19,591                  | 1/21/1890                      | Shubael Cottle                                     | various   |

## FOREIGN PATENT DOCUMENTS

[illegible]

|                       |          |                    |          |
|-----------------------|----------|--------------------|----------|
| Examiner<br>Signature | L.K. Bui | Date<br>Considered | 11/11/06 |
|-----------------------|----------|--------------------|----------|

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|   |      | Application Number       | 10/765501           |
|   |      | Filing Date              | 1/26/2004           |
|   |      | First Named Inventor     | David E. Huddleston |
|   |      | Art Unit                 |                     |
|   |      | Examiner Name            |                     |
| Sheet 3   | of 3 | Attorney Docket Number   | DEH1001             |

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|---------------------------------|-----------------------|---|----------------|
| Examiner Initials*              | Cite No. <sup>1</sup> | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published. | T <sup>2</sup> |
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|                                 | 42                    | printout from <a href="http://www.kreiser.net/trapphonpouc.html">http://www.kreiser.net/trapphonpouc.html</a> on Kreiser.Net Trapezoid Phone Pouch  |                |
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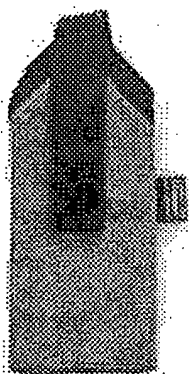
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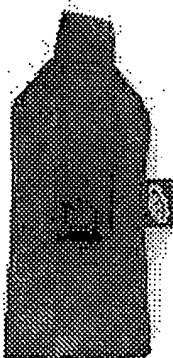


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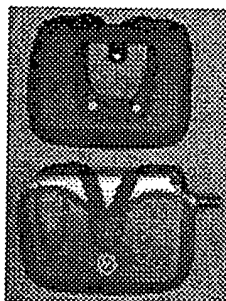


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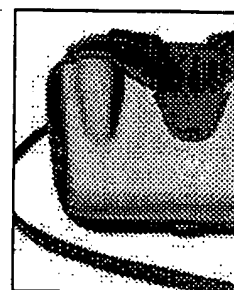
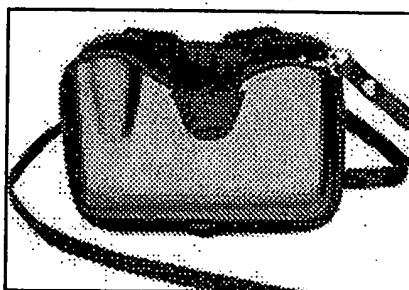
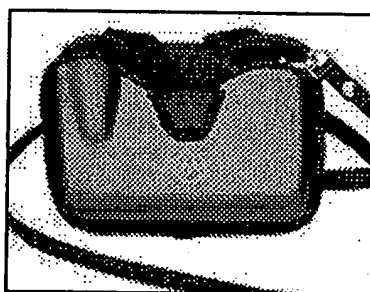


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Friday, December 12, 2003 - Page updated at 12:00 A.M.

NORTHWEST LI  
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Psst!

## Pamper your cellphone with Poire pouch

By Pamela Sitt

Seattle Times staff reporter

If you're like me, you feel naked  
without your cellphone.

Given my attachment, you'd think I'd take better care of my little pet. But I don't. I've been known to dump it out of my purse, crack the face under a stiletto heel and even drop it in the toilet.

If we can dress up toy dogs, why not dress up your *other* best friend?

Poire (French for "pear") protective pouches are the latest Japanese contribution to U.S. cellphone culture. Imported by Portland-based Mixx Inc., they are quickly spreading to Hollywood — Sandra Bullock and Tiffani Thiessen have them, as does the cast of ABC's "Hope and Faith."

"We'd never seen anything quite like it. It's so cute, it kind of hit our barometer just in the right way," said Juliette Fassett, president of Mixx Inc. "My phone is really small, and my bag is really big. I was always losing my phone."

Besides keeping your precious phone snug from dirt, grime and the remote possibility of spontaneous combustion — it's happened, though not to me — Poire pockets are stylish and fun. Pick from stripes, flowers, polka dots, animal prints or teddy bears to suit your personality.

And at \$10-\$20 a pop (available at Olivine, 5344 Ballard Ave. N.W., 206-706-4188), your cellphone can be the best-dressed in town.



Ⓜ enlarge

Treat your cellphone to Poire, which means pear in French but is a Japanese import that keeps phones safe and snug.

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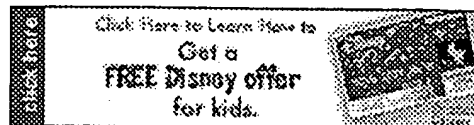
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## Cell Phone Pouch

by Priscilla Hewitt

Copyright ©2001, Priscilla's Crochet

*This pouch also works for sunglasses! It has both a belt loop and a strap.*

Difficulty level: \*\*(advanced beginner)

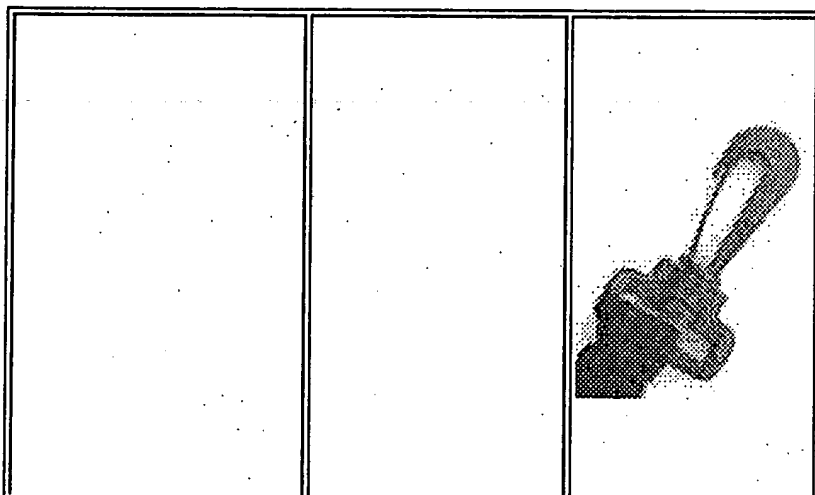
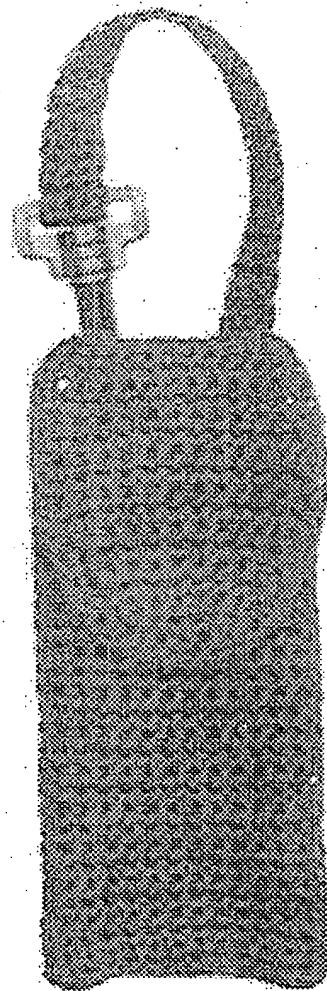
Materials: 100 yds. Speed-Cro-Sheen (size 3 thread), crochet hooks size E (3.50 mm) and size C (2.75 mm), or size needed to achieve gauge; 3" length of 3/4" velcro strip, snap buckle (see photo below), 3/4" luxite or cabone ring, yarn needle, sewing needle and matching thread.

Gauge: Rows 2-14 = 2 3/8" x 2 3/8"

Finished size closed: About 2 1/2" x 6"

To work a sc dec over 2 sts: Insert hook in the first indicated st and pull up a loop, insert hook in next indicated st and pull up a loop; yo and pull through all 3 remaining loops on hook.

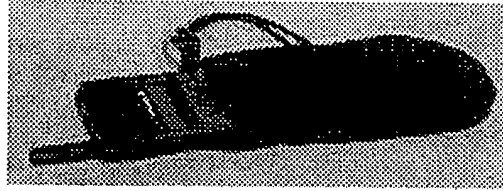
Pattern note: Work tightly for best results and to maintain gauge.



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## Mobile Phone Pouch



### Mobile Phone Pouch

Mobile Phone Pouch (Possum Pam)

Code: mobphonepouch

Price: \$21.00

Mobile Phone Pouch (Possum Pam)

**From NZ** is the working arm of Cybersales (NZ) Limited which is a young, dynamic and forward-thinking company. The company is owned by Stuart McFarlane.

It is our pleasure to offer you a range of high quality products sourced and manufactured in NZ, renowned for its pure air, its disease-free bees, its unpolluted seas and, of course, sheep, kiwi birds, the Silver Ferns and the All Blacks. Many of our products are unique to NZ.

We hope you have an enjoyable shopping experience within our store. Please contact us if you have any suggestions and comments about either our site or any of our products.



**Stuart is a part-time painter/artist, father of three, the pioneer of the mussel-farming industry in NZ and a developer of the anti-arthritis mussel extract known as Seatone™**

### SECURITY

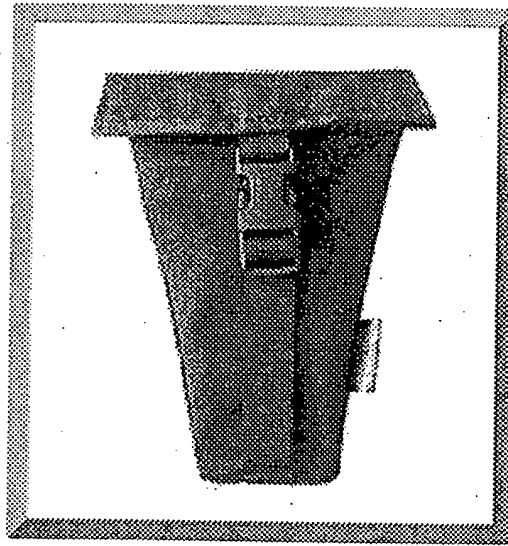
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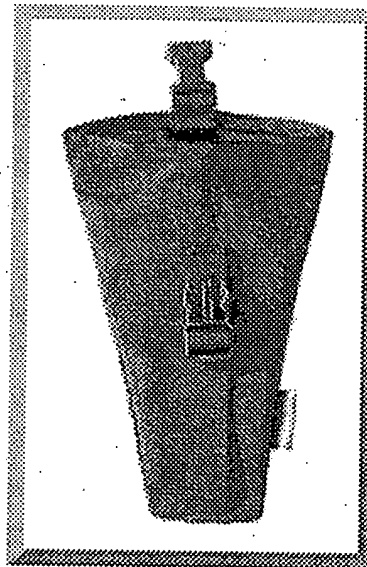
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## TRAPAZOID PHONE POUCH



**Rainproof pouch for carrying mobil phones, GPS units, and other important devices. Sealed seams keep water out. Attach this pouch securely to a belt, fannypack, or strap and keep your valuables handy.**

**Hold devices up to 6 inches high, 2 inches wide, and 1.5 inches deep. Pouch is 7 inches tall when closed. Durable buckle allows one-handed opening and closing.**

**\$19.00** Color: **Black**



**See our other Phone Pouches and Phone Chart**  
Click here to see our other waterproof phone cases or to see our chart of mobile phones that fit.



# Hi-Tek Phone Pouch

Style #: 981

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**Size:** 7"w x 6 1/2"h x 2" deep

**Material:** 1680-D Nylon

**Features:** A perfect way to keep your cell phone safe and secure. Attaches quickly to any shoulder strap or can also attach to a belt using the web strap with Velcro. The elastic pen loop offers a convenient way to hold a writing instrument. This item makes a great employee gift and is a proven winner for catalog programs or company stores.

**Color:** Black

**Imprint Size:** 1 1/2 " wide x 1 1/2" high

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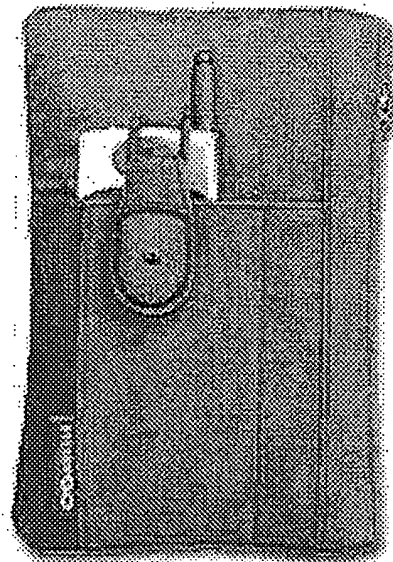
## Phone Pouch

**More info on this product available here>**

A great looking pouch designed to hold your phone as well as other useful necessities.

- ★ Holds mobile phone
- ★ Extra compartment secured with a zipper to store a wallet, tickets, makeup etc
- ★ Zip back pocket (that sits against body) to store valuables.
- ★ Adjustable shoulder strap
- ★ Modern design with combination of textures (rubberised fabric, semi mat polyester and elastic)
- ★ 11.5cm (4.5 inches) wide x 17.5cm (7 inches) high

**Price: \$28.95**



## II. APPLICATIONS WHICH HAVE ISSUED INTO U.S. PATENTS

### *A 35 U.S.C. 102(e) Rejection Cannot Rely on Matter Which Was Canceled from the Application and Thus Did Not Get Published in the Issued Patent*

Canceled matter in the application file of a U.S. patent cannot be relied upon in a rejection under 35 U.S.C. 102(e). *Ex Parte Stalego*, 154 USPQ 52, 53 (Bd. App. 1966). The canceled matter only becomes available as prior art as of the date the application issues into a patent since this is the date the application file \*>history< becomes available to the public. *In re Lund*, 376 F.2d 982, 153 USPQ 625 (CCPA 1967). For more information on available prior art for use in 35 U.S.C. 102(e) rejections see MPEP § 2136.02.

## III. FOREIGN APPLICATIONS OPEN FOR PUBLIC INSPECTION (LAID OPEN APPLICATIONS)

### *Laid Open Applications May Constitute "Published" Documents*

When the specification is not issued in printed form but is announced in an official journal and anyone can inspect or obtain copies, it is sufficiently accessible to the public to constitute a "publication" within the meaning of 35 U.S.C. 102(a) and (b). See *In re Wyer*, 655 F.2d 221, 210 USPQ 790 (CCPA 1981).

Older cases have held that laid open patent applications are not "published" and cannot constitute prior art. *Ex parte Haller*, 103 USPQ 332 (Bd. App. 1953). However, whether or not a document is "published" for the purposes of 35 U.S.C. 102 and 103 depends on how accessible the document is to the public. As technology has made reproduction of documents easier, the accessibility of the laid open applications has increased. Items provided in easily reproducible form have thus become "printed publications" as the phrase is used in 35 U.S.C. 102. *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981) (Laid open Australian patent application held to be a "printed publication" even though only the abstract was published because it was laid open for public inspection, microfilmed, "diaz copies" were distributed to five suboffices having suitable reproduction equipment and the diazo copies were available for sale.). The

contents of a foreign patent application should not be relied upon as prior art until the date of publication (i.e., the insertion into the laid open application) can be confirmed by an examiner's review of a copy of the document. See MPEP § 901.05.

## IV. PENDING U.S. APPLICATIONS

As specified in 37 CFR 1.14(a), all pending U.S. applications are preserved in confidence except for published applications, reissue applications, and applications in which a request to open the complete application to inspection by the public has been granted by the Office (37 CFR 1.11(b)). However, if an application that has not been published has an assignee or inventor in common with the application being examined, a rejection will be proper in some circumstances. For instance, when the claims between the two applications are not independent or distinct, a provisional double patenting rejection is made. See MPEP § 804. If the copending applications differ by at least one inventor and at least one of the applications would have been obvious in view of the other, a provisional rejection over 35 U.S.C. 102(e) or 103 is made when appropriate. See MPEP § 706.02(f)(2), § 706.02(k), § 706.02(l)(1), and § 706.02(l)(3).

See MPEP § 706.02(a), § 804 and § 2136 *et seq.* for information pertaining to rejections relying on U.S. application publications.

## 2128 "Printed Publications" as Prior Art

### A REFERENCE IS A "PRINTED PUBLICATION" IF IT IS ACCESSIBLE TO THE PUBLIC

A reference is proven to be a "printed publication" "upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it." *In re Wyer*, 655 F.2d 221, 210 USPQ 790 (CCPA 1981) (quoting *I.C.E. Corp. v. Armco Steel Corp.*, 250 F. Supp. 738, 743, 148 USPQ 537, 540 (SDNY 1966)) ("We agree that 'printed publication' should be approached as a unitary concept. The traditional dichotomy between 'printed' and 'publication' is no longer valid. Given the state of technology in document duplication, data storage, and data retrieval systems, the 'probability of dissemination' of an item very often has little to do with

whether or not it is 'printed' in the sense of that word when it was introduced into the patent statutes in 1836. In any event, interpretation of the words 'printed' and 'publication' to mean 'probability of dissemination' and 'public accessibility' respectively, now seems to render their use in the phrase 'printed publication' somewhat redundant.") *In re Wyer*, 655 F.2d at 226, 210 USPQ at 794.

See also *Carella v. Starlight Archery*, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986) (Starlight Archery argued that Carella's patent claims to an archery sight were anticipated under 35 U.S.C. 102(a) by an advertisement in a Wisconsin Bow Hunter Association (WBHA) magazine and a WBHA mailer prepared prior to Carella's filing date. However, there was no evidence as to when the mailer was received by any of the addressees. Plus, the magazine had not been mailed until 10 days after Carella's filing date. The court held that since there was no proof that either the advertisement or mailer was accessible to any member of the public before the filing date there could be no rejection under 35 U.S.C. 102(a).).

## ELECTRONIC PUBLICATIONS AS PRIOR ART

### *Status as a "Printed Publication"*

An electronic publication, including an on-line database or Internet publication, is considered to be a "printed publication" within the meaning of 35 U.S.C. 102(a) and (b) provided the publication was accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 227, 210 USPQ 790, 795 (CCPA 1981) ("Accordingly, whether information is printed, handwritten, or on microfilm or a magnetic disc or tape, etc., the one who wishes to characterize the information, in whatever form it may be, as a 'printed publication' \* \* \* should produce sufficient proof of its dissemination or that it has otherwise been available and accessible to persons concerned with the art to which the document relates and thus most likely to avail themselves of its contents." (citations omitted).). See also *Amazon.com v. Barnesandnoble.com*, 73 F. Supp. 2d 1228, 53 USPQ2d 1115, 1119 (W.D. Wash. 1999) (Pages from a website were relied on by defendants as an anticipatory reference (to no avail), however status of the reference as prior art was not challenged.); *In re*

*Epstein*, 32 F.3d 1559, 31 USPQ2d 1817 (Fed. Cir. 1994) (Database printouts of abstracts which were not themselves prior art publications were properly relied as providing evidence that the software products referenced therein were "first installed" or "released" more than one year prior to applicant's filing date.).

The Office policy requiring recordation of the field of search and search results (see MPEP § 719.05) weighs in favor of finding that Internet and on-line database references cited by the examiner are "accessible to persons concerned with the art to which the document relates and thus most likely to avail themselves of its contents." *Wyer*, 655 F.2d at 221, 210 USPQ at 790. Office copies of an electronic document must be retained if the same document may not be available for retrieval in the future. This is especially important for sources such as the Internet and online databases.

### *Date of Availability*

Prior art disclosures on the Internet or on an on-line database are considered to be publicly available as of the date the item was publicly posted. If the publication does not include a publication date (or retrieval date), it cannot be relied upon as prior art under 35 U.S.C. 102(a) or (b), although it may be relied upon to provide evidence regarding the state of the art. Examiners may ask the Scientific and Technical Information Center to find the earliest date of publication. See MPEP § 901.06(a), paragraph IV. G.

### *Extent of Teachings Relied Upon*

An electronic publication, like any publication, may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See MPEP § 2121.01 and § 2123. Note, however, that if an electronic document which is the abstract of a patent or printed publication is relied upon in a rejection under 35 U.S.C. 102 or 103, only the text of the abstract (and not the underlying document) may be relied upon to support the rejection. In situations where the electronic version and the published paper version of the same or a corresponding patent or printed publication differ appreciably, each may need to be cited and relied upon as independent references based on what they disclose.

**Internet Usage Policy**

See MPEP § 904.02(c) for the portions of the Internet Usage Policy pertaining to Internet searching and documenting search strategies. See MPEP § 707.05 for the proper citation of electronic documents.

**EXAMINER NEED NOT PROVE ANYONE ACTUALLY LOOKED AT THE DOCUMENT**

One need not prove someone actually looked at a publication when that publication is accessible to the public through a library or patent office. See *In re Wyer*, 655 F.2d 221, 210 USPQ 790 (CCPA 1981); *In re Hall*, 781 F.2d 897, 228 USPQ 453 (Fed. Cir. 1986).

**2128.01 Level of Public Accessibility Required [R-3]****I. A THESIS PLACED IN A UNIVERSITY LIBRARY MAY BE PRIOR ART IF SUFFICIENTLY ACCESSIBLE TO THE PUBLIC**

A doctoral thesis indexed and shelved in a library is sufficiently accessible to the public to constitute prior art as a "printed publication." *In re Hall*, 781 F.2d 897, 228 USPQ 453 (Fed. Cir. 1986). Even if access to the library is restricted, a reference will constitute a "printed publication" as long as a presumption is raised that the portion of the public concerned with the art would know of the invention. *In re Bayer*, 568 F.2d 1357, 196 USPQ 670 (CCPA 1978).

In *In re Hall*, general library cataloging and shelving practices showed that a doctoral thesis deposited in university library would have been indexed, cataloged and shelved and thus available to the public before the critical date. Compare *In re Cronyn*, 890 F.2d 1158, 13 USPQ2d 1070 (Fed. Cir. 1989) wherein doctoral theses were shelved and indexed by index cards filed alphabetically by student name and kept in a shoe box in the chemistry library. The index cards only listed the student name and title of the thesis. Two of three judges held that the students' theses were not accessible to the public. The court reasoned that the theses had not been either cataloged or

indexed in a meaningful way since thesis could only be found if the researcher's name was known, but the name bears no relationship to the subject of the thesis. One judge, however, held that the fact that the theses were shelved in the library was enough to make them sufficiently accessible to the public. The nature of the index was not determinative. This judge relied on prior Board decisions (*Gulliksen v. Halberg*, 75 USPQ 252, 257 (Bd. App. 1937) and *Ex parte Hershberger*, 96 USPQ 54, 56 (Bd. App. 1952)), which held that shelving a single copy in a public library makes the work a "printed publication." It should be noted that these Board decisions have not been expressly overruled but have been criticized in other decisions. See *In re Tenney*, 254 F.2d 619, 117 USPQ 348 (CCPA 1958) (concurring opinion by *J. Rich*) (A document, of which there is but one copy, whether it be handwritten, typewritten or on microfilm, may be technically accessible to anyone who can find it. Such a document is not "printed" in the sense that a printing press has been used to reproduce the document. If only technical accessibility were required "logic would require the inclusion within the term [printed] of all unprinted public documents for they are all 'accessible.' While some tribunals have gone quite far in that direction, as in the 'college thesis cases' I feel they have done so unjustifiably and on the wrong theory. Knowledge is not in the possession of the public where there has been no dissemination, as distinguished from technical accessibility..." The real significance of the word "printed" is grounded in the "probability of wide circulation." See also *Deep Welding, Inc. v. Sciaky Bros.*, 417 F.2d 1227, 163 USPQ 144 (7th Cir. 1969) (calling the holding of *Ex parte Hershberger* "extreme"). Compare *In re Bayer*, 568 F.2d 1357, 196 USPQ 670 (CCPA 1978) (A reference will constitute a "printed publication" as long as a presumption is raised that the portion of the public concerned with the art would know of the invention even if accessibility is restricted to only this part of the public. But accessibility to applicant's thesis was restricted to only three members of a graduate committee. There can be no presumption that those concerned with the art would have known of the invention in this case.).

## II. ORALLY PRESENTED PAPER CAN CONSTITUTE A "PRINTED PUBLICATION" IF WRITTEN COPIES ARE AVAILABLE WITHOUT RESTRICTION

A paper which is orally presented in a forum open to all interested persons constitutes a "printed publication" if written copies are disseminated without restriction. *Massachusetts Institute of Technology v. AB Fortia*, 774 F.2d 1104, 1109, 227 USPQ 428, 432 (Fed. Cir. 1985) (Paper orally presented to between 50 and 500 persons at a scientific meeting open to all persons interested in the subject matter, with written copies distributed without restriction to all who requested, is a printed publication. Six persons requested and obtained copies.).

## III. INTERNAL DOCUMENTS INTENDED TO BE CONFIDENTIAL ARE NOT "PRINTED PUBLICATIONS"

Documents and items only distributed internally within an organization which are intended to remain confidential are not "printed publications" no matter how many copies are distributed. There must be an existing policy of confidentiality or agreement to remain confidential within the organization. Mere intent to remain confidential is insufficient. *In re George*, 2 USPQ2d 1880 (Bd. Pat. App. & Inter. 1987) (Research reports disseminated in-house to only those persons who understood the policy of confidentiality regarding such reports are not printed publications even though the policy was not specifically stated in writing.); *Garret Corp. v. United States*, 422 F.2d 874, 878, 164 USPQ 521, 524 (Ct. Cl. 1970) ("While distribution to government agencies and personnel alone may not constitute publication ... distribution to commercial companies without restriction on use clearly does."); *Northern Telecom Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990) (Four reports on the AESOP-B military computer system which were not under security classification were distributed to about fifty organizations involved in the AESOP-B project. One document contained the legend "Reproduction or further dissemination is not authorized." The other documents were of the class that would contain this legend. The documents were housed in Mitre Corporation's library. Access to this library was restricted to those involved in the AESOP-B project.

The court held that public access was insufficient to make the documents "printed publications.").

>

## IV. PUBLICLY DISPLAYED DOCUMENTS CAN CONSTITUTE A "PRINTED PUBLICATION" EVEN IF THE DURATION OF DISPLAY IS FOR ONLY A FEW DAYS AND THE DOCUMENTS ARE NOT DISSEMINATED BY COPIES OR INDEXED IN A LIBRARY OR DATABASE

A publicly displayed document where persons of ordinary skill in the art could see it and are not precluded from copying it can constitute a "printed publication," even if it is not disseminated by the distribution of reproductions or copies and/or indexed in a library or database. As stated in *In re Klopferstein*, 380 F.3d 1345, 1348, 72 USPQ2d 1117, 1119 (Fed. Cir. 2004), "the key inquiry is whether or not a reference has been made 'publicly accessible.'" Prior to the critical date, a fourteen-slide presentation disclosing the invention was printed and pasted onto poster boards. The printed slide presentation was displayed with no confidentiality restrictions for approximately three cumulative days at two different industry events. 380 F.3d at 1347, 72 USPQ2d at 1118. The court noted that "an entirely oral presentation that includes neither slides nor copies of the presentation is without question not a 'printed publication' for the purposes of 35 U.S.C. § 102(b). Furthermore, a presentation that includes a transient display of slides is likewise not necessarily a 'printed publication.'" 380 F.3d at 1349 n.4, 72 USPQ2d at 1122 n.4. In resolving whether or not a temporarily displayed reference that was neither distributed nor indexed was nonetheless made sufficiently publicly accessible to count as a "printed publication" under 35 U.S.C. 102(b), the court considered the following factors: "the length of time the display was exhibited, the expertise of the target audience, the existence (or lack thereof) of reasonable expectations that the material displayed would not be copied, and the simplicity or ease with which the material displayed could have been copied." 380 F.3d at 1350, 72 USPQ2d at 1120. Upon reviewing the above factors, the court concluded that the display "was sufficiently publicly accessible to count as a 'printed publication.'" 380 F.3d at 1352, 72 USPQ2d at 1121.<

## 2128.02 Date Publication Is Available as a Reference

### DATE OF ACCESSIBILITY CAN BE SHOWN THROUGH EVIDENCE OF ROUTINE BUSINESS PRACTICES

Evidence showing routine business practices can be used to establish the date on which a publication became accessible to the public. Specific evidence showing when the specific document actually became available is not always necessary. *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir.), *cert. denied*, 988 U.S. 892 (1988) (Court held that evidence submitted by Intel regarding undated specification sheets showing how the company usually treated such specification sheets was enough to show that the sheets were accessible by the public before the critical date.); *In re Hall*, 781 F.2d 897, 228 USPQ 453 (Fed. Cir. 1986) (Librarian's affidavit establishing normal time frame and practice for indexing, cataloging and shelving doctoral theses established that the thesis in question would have been accessible by the public before the critical date.).

### A JOURNAL ARTICLE OR OTHER PUBLICATION BECOMES AVAILABLE AS PRIOR ART ON DATE OF IT IS RECEIVED BY A MEMBER OF THE PUBLIC

A publication disseminated by mail is not prior art until it is received by at least one member of the public. Thus, a magazine or technical journal is effective as of its date of publication (date when first person receives it) not the date it was mailed or sent to the publisher. *In re Schlittler*, 234 F.2d 882, 110 USPQ 304 (CCPA 1956).

## 2129 Admissions as Prior Art [R-3]

### I. ADMISSIONS BY APPLICANT CONSTITUTE PRIOR ART

A statement by an applicant during prosecution identifying the work of another as "prior art" is an admission that that work is available as prior art against the claims, regardless of whether the admitted prior art would otherwise qualify as prior art under the statutory categories of 35 U.S.C. 102. *Riverwood Int'l*

*Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1354, 66 USPQ2d 1331, 1337 (Fed. Cir. 2003). However, even if labeled as "prior art," the work of the same inventive entity may not be considered prior art against the claims unless it falls under one of the statutory categories. *Id.*; see also *Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 650, 223 USPQ 1168, 1172 (Fed. Cir. 1984) ("[W]here the inventor continues to improve upon his own work product, his foundational work product should not, without a statutory basis, be treated as prior art solely because he admits knowledge of his own work. It is common sense that an inventor, regardless of an admission, has knowledge of his own work.").

Consequently, the examiner must determine whether the subject matter identified as "prior art" is applicant's own work, or the work of another. In the absence of another credible explanation, examiners should treat such subject matter as the work of another.

### II. DISCUSSION OF PRIOR ART IN SPECIFICATION

Where the specification identifies work done by another as "prior art," the subject matter so identified is treated as admitted prior art. *In re Nomiya*, 509 F.2d 566, 571, 184 USPQ 607, 611 (CCPA 1975) (holding applicant's labeling of two figures in the application drawings as "prior art" to be an admission that what was pictured was prior art relative to applicant's improvement).

### III. JEPSON CLAIMS

Drafting a claim in *Jepson* format (i.e., the format described in 37 CFR 1.75(e); see MPEP § 608.01(m)) is taken as an implied admission that the subject matter of the preamble is the prior art work of another. *In re Fout*, 675 F.2d 297, 301, 213 USPQ 532, 534 (CCPA 1982) (holding preamble of *Jepson*-type claim to be admitted prior art where applicant's specification credited another as the inventor of the subject matter of the preamble). However, this implication may be overcome where applicant gives another credible reason for drafting the claim in *Jepson* format. *In re Ehrreich*, 590 F.2d 902, 909-910, 200 USPQ 504, 510 (CCPA 1979) (holding preamble not to be admitted prior art where applicant explained that the *Jepson*

the various elements do not function simultaneously, are not directly functionally related, do not directly intercooperate, and/or serve independent purposes.)<

## 2173 Claims Must Particularly Point Out and Distinctly Claim the Invention

The primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent. A secondary purpose is to provide a clear measure of what applicants regard as the invention so that it can be determined whether the claimed invention meets all the criteria for patentability and whether the specification meets the criteria of 35 U.S.C. 112, first paragraph with respect to the claimed invention.

### 2173.01 Claim Terminology [R-2]

A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as \*\*>any special meaning assigned to a term is clearly set forth in the specification. See MPEP § 2111.01.< Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

### 2173.02 Clarity and Precision [R-3]

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define the patentable subject matter with a reasonable degree of partic-

ularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.

The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. See, e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). See also *In re Larsen*, No. 01-1092 (Fed. Cir. May 9, 2001) (unpublished) (The preamble of the *Larsen* claim recited only a hanger and a loop but the body of the claim positively recited a linear member. The court observed that the totality of all the limitations of the claim and their interaction with each other must be considered to ascertain the inventor's contribution to the art. Upon review of the claim in its entirety, the court concluded that the claim at issue apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112 paragraph 2.). >See also *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004) ("The requirement to 'distinctly' claim means that the claim must have a meaning discernible to one of ordinary skill in the art when construed according to correct principles....Only when a claim remains

insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must a court declare it indefinite.”).

Accordingly, a claim term that is not used or defined in the specification is not indefinite if the meaning of the claim term is discernible. *Bancorp Services, L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372, 69 USPQ2d 1996, 1999-2000 (Fed. Cir. 2004) (holding that the disputed claim term “surrender value protected investment credits” which was not defined or used in the specification was discernible and hence not indefinite because “the components of the term have well recognized meanings, which allow the reader to infer the meaning of the entire phrase with reasonable confidence”).<

If the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. 112, second paragraph, would be appropriate. See *Morton Int'l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993). However, if the language used by applicant satisfies the statutory requirements of 35 U.S.C. 112, second paragraph, but the examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. 112, second paragraph, rather, the examiner should suggest improved language to the applicant.

For example, a claim recites “a suitable liquid such as the filtrate of the contaminated liquid to be filtered and solids of a filtering agent such as perlite, cellulose powder, etc.” The mere use of the phrase “such as” in the claim does not by itself render the claim indefinite. Office policy is not to employ *per se* rules to make technical rejections. Examples of claim language which have been held to be indefinite set forth in MPEP § 2173.05(d) are fact specific and should not be applied as *per se* rules. The test for definiteness under 35 U.S.C. 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). If one skilled in the art is able to ascertain in the example above, the meaning of the terms “suitable liquid” and “solids of a filtering agent” in light of the specification, 35 U.S.C. 112,

second paragraph, is satisfied. If upon review of the claim as a whole in light of the specification, the examiner determines that a rejection under 35 U.S.C. 112, second paragraph, is not appropriate in the above-noted example, but is of the opinion that the clarity and the precision of the language can be improved by the deletion of the phrase “such as” in the claim, the examiner may make such a suggestion to the applicant. If applicant does not accept the examiner’s suggestion, the examiner should not pursue the issue.

If upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C. 112, second paragraph, is appropriate, such a rejection should be made and an analysis as to why the phrase(s) used in the claim is “vague and indefinite” should be included in the Office action. If applicants traverse the rejection, with or without the submission of an amendment, and the examiner considers applicant’s arguments to be persuasive, the examiner should indicate in the next Office communication that the previous rejection under 35 U.S.C. 112, second paragraph, has been withdrawn and provide an explanation as to what prompted the change in the examiner’s position (e.g., examiners may make specific reference to portions of applicant’s remarks that were considered to be the basis as to why the previous rejection was withdrawn).

By providing an explanation as to the action taken, the examiner will enhance the clarity of the prosecution history record. As noted by the Supreme Court in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 122 S.Ct. 1831, 1838, 62 USPQ2d 1705, 1710 (2002), a clear and complete prosecution file record is important in that “[p]rosecution history estoppel requires that the claims of a patent be interpreted in light of the proceedings in the PTO during the application process.” In *Festo*, the court held that “a narrowing amendment made to satisfy any requirement of the Patent Act may give rise to an estoppel.” With respect to amendments made to comply with the requirements of 35 U.S.C. 112, the court stated that “[i]f a § 112 amendment is truly cosmetic, then it would not narrow the patent’s scope or raise an estoppel. On the other hand, if a § 112 amendment is necessary and narrows the patent’s scope—even if only for the purpose of better description—estoppel may apply.” *Id.*, at 1840, 62 USPQ2d at 1712. The court



further stated that “when the court is unable to determine the purpose underlying a narrowing amendment—and hence a rationale for limiting the estoppel to the surrender of particular equivalents—the court should presume that the patentee surrendered all subject matter between the broader and the narrower language...the patentee should bear the burden of showing that the amendment does not surrender the particular equivalent in question.” *Id.*, at 1842, 62 USPQ2d at 1713. Thus, whenever possible, the examiner should make the record clear by providing explicit reasoning for making or withdrawing any rejection related to 35 U.S.C. 112, second paragraph.

### **2173.03 Inconsistency Between Claim >and< Specification Disclosure or Prior Art [R-1] [R-1]**

Although the terms of a claim may appear to be definite, inconsistency with the specification disclosure or prior art teachings may make an otherwise definite claim take on an unreasonable degree of uncertainty. *In re Cohn*, 438 F.2d 989, 169 USPQ 95 (CCPA 1971); *In re Hammack*, 427 F.2d 1378, 166 USPQ 204 (CCPA 1970). In *Cohn*, the claim was directed to a process of treating a surface with a corroding solution until the metallic appearance is supplanted by an “opaque” appearance. Noting that no claim may be read apart from and independent of the supporting disclosure on which it is based, the court found that the description, definitions and examples set forth in the specification relating to the appearance of the surface after treatment were inherently inconsistent and rendered the claim indefinite.

### **2173.04 Breadth Is Not Indefiniteness**

Breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.

Undue breadth of the claim may be addressed under different statutory provisions, depending on the reasons for concluding that the claim is too broad. If the claim is too broad because it does not set forth that

which applicants regard as their invention as evidenced by statements outside of the application as filed, a rejection under 35 U.S.C. 112, second paragraph, would be appropriate. If the claim is too broad because it is not supported by the original description or by an enabling disclosure, a rejection under 35 U.S.C. 112, first paragraph, would be appropriate. If the claim is too broad because it reads on the prior art, a rejection under either 35 U.S.C. 102 or 103 would be appropriate.

### **2173.05 Specific Topics Related to Issues Under 35 U.S.C. 112, Second Paragraph [R-1]**

The following sections are devoted to a discussion of specific topics where issues under 35 U.S.C. 112, second paragraph, have been addressed. These sections are not intended to be an exhaustive list of the issues that can arise under 35 U.S.C. 112, second paragraph, but are intended to provide guidance in areas that have been addressed with some frequency in recent examination practice. The court and Board decisions cited are representative. As with all appellate decisions, the results are largely dictated by the facts in each case. The use of the same language in a different context may justify a different result.

>See MPEP § 2181 for guidance in determining whether an applicant has complied with the requirements of 35 U.S.C. 112, second paragraph, when 35 U.S.C. 112, sixth paragraph, is invoked.<

### **2173.05(a) New Terminology [R-3]**

#### **I. THE MEANING OF EVERY TERM SHOULD BE APPARENT**

The meaning of every term used in a claim should be apparent from the prior art or from the specification and drawings at the time the application is filed. Applicants need not confine themselves to the terminology used in the prior art, but are required to make clear and precise the terms that are used to define the invention whereby the metes and bounds of the claimed invention can be ascertained. During patent examination, the pending claims must be given the broadest reasonable interpretation consistent with the specification. *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Prater*,

**Examiner Note:**

1. In bracket 2, insert the name(s) of the newly discovered reference.
2. Any action including this form paragraph requires the signature of a Primary Examiner. MPEP § 1004.

**706.05 Rejection After Allowance of Application**

See MPEP § 1308.01 for a rejection based on a reference after allowance.

**706.06 Rejection of Claims Copied From Patent [R-3]**

See MPEP \*>Chapter 2300<.

**706.07 Final Rejection [R-3]**

37 CFR 1.113. *Final rejection or action.*

\*\*>

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.<

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to

another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.

While the rules no longer give to an applicant the right to "amend as often as the examiner presents new references or reasons for rejection," present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application. But the applicant who dallies in the prosecution of his or her application, resorting to technical or other obvious subterfuges in order to keep the application pending before the primary examiner, can no longer find a refuge in the rules to ward off a final rejection.

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal. However, it is to the interest of the applicants as a class as well as to that of the public that prosecution of an application be confined to as few actions as is consistent with a thorough consideration of its merits.

Neither the statutes nor the Rules of Practice confer any right on an applicant to an extended prosecution; *Ex parte Hoogendam*, 1939 C.D. 3, 499 O.G.3, 40 USPQ 389 (Comm'r Pat. 1939).

**STATEMENT OF GROUNDS**

In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection.

However, where a single previous Office action contains a complete statement of a ground of rejection, the final rejection may refer to such a statement and also should include a rebuttal of any arguments

raised in the applicant's reply. If appeal is taken in such a case, the examiner's answer should contain a complete statement of the examiner's position. The final rejection letter should conclude with Form Paragraph 7.39.

#### ¶ 7.39 Action Is Final

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

#### Examiner Note:

1. This form paragraph should not be used in reissue litigation cases (SSP- 1 month) or in reexamination proceedings (SSP- 1 or 2 months).
2. 37 CFR 1.136(a) should not be available in a reissue litigation case and is not available in reexamination proceedings.

Form paragraph 7.39.01 may be used to notify applicant of options available after final rejection.

#### ¶ 7.39.01 Final Rejection, Options for Applicant, Pro Se

This action is a **final rejection** and is intended to close the prosecution of this application. Applicant's reply under 37 CFR 1.113 to this action is limited either to an appeal to the Board of Patent Appeals and Interferences or to an amendment complying with the requirements set forth below.

If applicant should desire to appeal any rejection made by the examiner, a Notice of Appeal must be filed within the period for reply identifying the rejected claim or claims appealed. The Notice of Appeal must be accompanied by the required appeal fee of \$[1].

If applicant should desire to file an amendment, entry of a proposed amendment after final rejection cannot be made as a matter of right unless it merely cancels claims or complies with a formal requirement made earlier. Amendments touching the merits of the application which otherwise might not be proper may be admitted upon a showing a good and sufficient reasons why they are necessary and why they were not presented earlier.

A reply under 37 CFR 1.113 to a final rejection must include the appeal from, or cancellation of, each rejected claim. The filing of an amendment after final rejection, whether or not it is entered, does not stop the running of the statutory period for reply to the final rejection unless the examiner holds the claims to be in condition for allowance. Accordingly, if a Notice of Appeal has not been filed properly within the period for reply, or any extension of

this period obtained under either 37 CFR 1.136(a) or (b), the application will become abandoned.

#### Examiner Note:

The form paragraph must be preceded by any one of form paragraphs 7.39, 7.40, 7.40.01, 7.41, 7.42.03, or 7.42.09.

The Office Action Summary Form PTOL-326 should be used in all Office actions up to and including final rejections.

For amendments filed after final rejection, see MPEP § 714.12 and § 714.13.

For final rejection practice in reexamination proceedings see MPEP § 2271.

### 706.07(a) Final Rejection, When Proper on Second Action [R-3]

Due to the change in practice as affecting final rejections, older decisions on questions of prematureness of final rejection or admission of subsequent amendments do not necessarily reflect present practice.

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). Where information is submitted in an information disclosure statement during the period set forth in 37 CFR 1.97(c) with a fee, the examiner may use the information submitted, e.g., a printed publication or evidence of public use, and make the next Office action final whether or not the claims have been amended, provided that no other new ground of rejection which was not necessitated by amendment to the claims is introduced by the examiner. See MPEP § 609.04(b)<. Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17 (p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art. Where information is submitted in a reply to a requirement

under 37 CFR 1.105; the examiner may NOT make the next Office action relying on that art final unless all instances of the application of such art are necessitated by amendment.

A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed. See MPEP § 904 *et seq.* For example, one would reasonably expect that a rejection under 35 U.S.C. 112 for the reason of incompleteness would be replied to by an amendment supplying the omitted element.

A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings may not be made final if it contains a new ground of rejection necessitated by the amendments to 35 U.S.C. 102(e) by the Intellectual Property and High Technology Technical Amendments Act of 2002 (Pub. L. 107-273, 116 Stat. 1758 (2002)), unless the new ground of rejection was necessitated by an amendment to the claims or as a result of information submitted in an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

When applying any 35 U.S.C. 102(e)/103 references against the claims of an application \*\* the examiner should anticipate that a statement averring common ownership at the time the invention was made may disqualify any patent or application applied in a rejection under 35 U.S.C. 103 based on 35 U.S.C. 102(e). If such a statement is filed in reply to the 35 U.S.C. 102(e)/103 rejection and the claims are not amended, the examiner may not make the next Office action final if a new rejection is made. See MPEP § 706.02(1)(3).>If a reference is disqualified under the joint research agreement provision of 35 U.S.C. 103(c) and a new subsequent double patenting rejection based upon the disqualified reference is applied, the next Office action, which contains the new double patenting rejection, may be made final even if applicant did not amend the claims (provided that the examiner introduces no other new ground of rejection that was not necessitated by either amendment or an information disclosure statement filed during the time period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)). The Office action is prop-

erly made final because the new double patenting rejection was necessitated by amendment of the application by applicant.<

See MPEP § 809.02(a) for actions which indicate generic claims as not allowable.

In the consideration of claims in an amended case where no attempt is made to point out the patentable novelty, the examiner should be on guard not to allow such claims. See MPEP § 714.04. The claims may be finally rejected if, in the opinion of the examiner, they are clearly open to rejection on grounds of record.

Form paragraph 7.40 should be used where an action is made final including new grounds of rejection necessitated by applicant's amendment.

#### ¶ 7.40 Action Is Final, Necessitated by Amendment

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

#### Examiner Note:

1. This form paragraph should not be used in reissue litigation cases (SSP- 1 month) or in reexamination proceedings (SSP- 1 or 2 months).
2. 37 CFR 1.136(a) should not be available in a reissue litigation case and is not available in reexamination proceedings.

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#### ¶ 7.40.01 Action Is Final, Necessitated by IDS With Fee

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on [1] prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant

to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Examiner Note:**

1. This form paragraph should not be used and a final rejection is improper where there is another new ground of rejection introduced by the examiner which was not necessitated by amendment to the claims.
2. In bracket 1, insert the filing date of the information disclosure statement containing the identification of the item of information used in the new ground of rejection.

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**¶ 7.40.02 Action Is Final, Necessitated by Invoking the Joint Research Agreement Prior Art Exclusion Under 35 U.S.C. 103(c)**

Applicant's submission of the requirements for the joint research agreement prior art exclusion under 35 U.S.C. 103(c) on [1] prompted the new ground(s) of rejection under 37 CFR 1.109(b) presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.02(l)(3). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Examiner Note:**

1. This form paragraph should not be used and a final rejection is improper where there is another new ground of rejection introduced by the examiner which was not necessitated by amendment to the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).
2. In bracket 1, insert the filing date of the submission of the requirements for the joint research agreement prior art exclusion under 35 U.S.C. 103(c).

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**706.07(b) Final Rejection, When Proper on First Action [R-1]**

The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing applica-

tion of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.

>A first Office action in a continuing or substitute application may not be made final if it contains a new ground of rejection necessitated by the amendments to 35 U.S.C. 102(e) by the Intellectual Property and High Technology Technical Amendments of 2002 (Pub. L. 107-273, 116 Stat. 1758 (2002)).<

However, it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised.

Further, it would not be proper to make final a first Office action in a continuation-in-part application where any claim includes subject matter not present in the earlier application.

A request for an interview prior to first action on a continuing or substitute application should ordinarily be granted.

A first action final rejection should be made by using Form Paragraphs 7.41 or 7.41.03, as appropriate.

**¶ 7.41 Action Is Final, First Action**

This is a [1] of applicant's earlier Application No. [2]. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Examiner Note:**

1. In bracket 1, insert either --continuation-- or --substitute--, as appropriate.
2. If an amendment was refused entry in the parent case on the grounds that it raised new issues or new matter, this form paragraph cannot be used. See MPEP § 706.07(b).
3. This form paragraph should **not** be used in reissue litigation cases (SSP- 1 month) or in reexamination proceedings (SSP-1 or 2 months).
4. 37 CFR 1.136(a) should not be available in a reissue litigation case and is not available in reexamination proceedings.

**¶ 7.41.03 Action Is Final, First Action Following Submission Under 37 CFR 1.53(d), Continued Prosecution Application (CPA)**

All claims are drawn to the same invention claimed in the parent application prior to the filing of this Continued Prosecution Application under 37 CFR 1.53(d) and could have been finally rejected on the grounds and art of record in the next Office action. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing under 37 CFR 1.53(d). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

**Examiner Note:**

1. This form paragraph is for a first action final rejection in a Continued Prosecution Application filed under 37 CFR 1.53(d).
2. This form paragraph must be prof \_\_\_\_\_ form paragraphs 2.30 or 2.35, as appropriate.

**¶ 7.42.09 Action Is Final, First Action Following Request for Continued Examination under 37 CFR 1.114**

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened stat-

utory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

**Examiner Note:**

This form paragraph is for a first action final rejection following a Request for Continued Examination filed under 37 CFR 1.114.

### **706.07(c) Final Rejection, Premature**

Any question as to prematurity of a final rejection should be raised, if at all, while the application is still pending before the primary examiner. This is purely a question of practice, wholly distinct from the tenability of the rejection. It may therefore not be advanced as a ground for appeal, or made the basis of complaint before the Board of Patent Appeals and Interferences. It is reviewable by petition under 37 CFR 1.181. See MPEP § 1002.02(c).

### **706.07(d) Final Rejection, Withdrawal of, Premature**

If, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection. The finality of the Office action must be withdrawn while the application is still pending. The examiner cannot vacate the final rejection once the application is abandoned.

Form paragraph 7.42 should be used when withdrawing the finality of the rejection of the last Office action.

**¶ 7.42 Withdrawal of Finality of Last Office Action**

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### **706.07(e) Withdrawal of Final Rejection, General**

See MPEP § 714.12 and § 714.13 for amendments after final rejection.

Once a final rejection that is not premature has been entered in an application/reexamination proceeding, it should not be withdrawn at the applicant's or patent owner's request except on a showing under 37 CFR 1.116(b). Further amendment or argument will be

# UNITED STATES PATENT OFFICE.

MINNIE LINDHEIM, OF NEW YORK, N. Y.

## IMPROVEMENT IN TOBACCO-BAGS.

Specification forming part of Letters Patent No. 213,580, dated March 25, 1879; application filed November 6, 1878.

*To all whom it may concern:*

Be it known that I, MINNIE LINDHEIM, of the city and State of New York, have invented a new and Improved Package for Tobacco and other articles; and I hereby declare the following to be a full, clear, and exact description thereof, reference being had to the accompanying drawings, making part of this specification, in which—

Figure 1 is a side view of my package with the retaining-string drawn. Fig. 2 is a view of the package distended. Fig. 3 is a view of the package filled and ready for market.

Heretofore it has been customary to pack tobacco and like articles in muslin bags having straight sides and provided with a drawing-string running through a hem around the edge of the open end, the said drawing-string drawing the mouth together after the tobacco has been compressed into the bag, and being tied to retain the tobacco in the package. In most instances purchasers of tobacco put up in this way desire to retain the bag as a pouch from which to use the tobacco from time to time, and are much inconvenienced in this desire from the fact that the moment the drawing-string is loosened to take out a pipeful of the tobacco the elasticity of the compressed tobacco will bulge it up, so the mouth of the bag cannot again be closed to prevent the escape of tobacco into the pocket and consequent wastage.

To overcome this difficulty is the object of my invention; and it consists in a bag of substantially the ordinary formation, provided with a drawing-string to keep the tobacco in place when packed, and above this drawing-string with an extension, flaring or otherwise, provided near its edge with a drawing-string.

In order that those skilled in the art may make and use my invention, I will proceed to

describe the manner in which I have carried it out.

In the said drawings, A is a tobacco package or bag, provided with an extension, B, preferably flaring, which commences immediately at a drawing-string, c, intended to retain the tobacco packed in portion A, which is made of a capacity to contain any desired amount of tobacco. Near the edge of the flaring portion B is another drawing-string, D, for the purpose hereinafter set forth.

While the tobacco is being placed in portion A, to be compressed as usual, the flaring portion serves to direct it in its course. After portion A is filled string c is drawn, as seen in Fig. 1, and subsequently the flaring extension is folded down and the revenue-stamp applied, or otherwise prepared for market in a neat salable package, as seen in Fig. 3.

When the purchaser buys the package of tobacco he simply cuts string c, raises extension B, and has a handy tobacco-pouch to carry in his pocket, the mouth being controlled by string D.

Though I have shown the extension-piece B made with flaring sides, it is evident it can be made with straight sides without departing from the spirit of my invention.

Having thus described my invention, what I claim as new, and desire to secure by Letters Patent, is—

A tobacco-package constructed as described, consisting of the body A, provided with a fastening device, c, and the extension B, provided with fastening device D near its mouth, substantially as set forth.

MINNIE LINDHEIM.

Witnesses:

EDWARD COHN,  
A. S. MEYER.

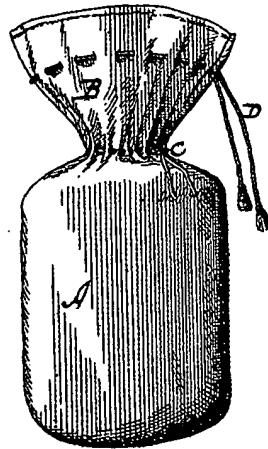
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M. LINDHEIM.  
Tobacco-Bag.

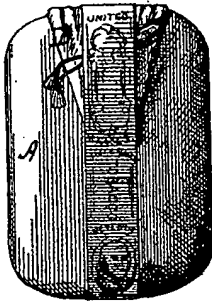
No. 213,580.

Patented Mar. 25, 1879.

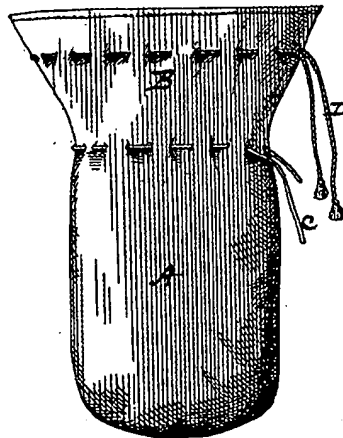
*Fig. 1.*



*Fig. 3.*



*Fig. 2.*



*Witnesses:*

*Clarence Poole*  
*A. H. Gawler.*

*Inventor:*

*Minnie Lindheim*  
*by her attys*  
*A. H. Evans & Co.*

H. PETER, PHOTO-LITHOGRAPHER, WASHINGTON, D. C.

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No. 665,942.

J. N. TABLER.

Patented Jan. 15, 1901.

MAIL-POUCH.

(Application filed June 9, 1900.)

(No Model.)

Fig. 1.

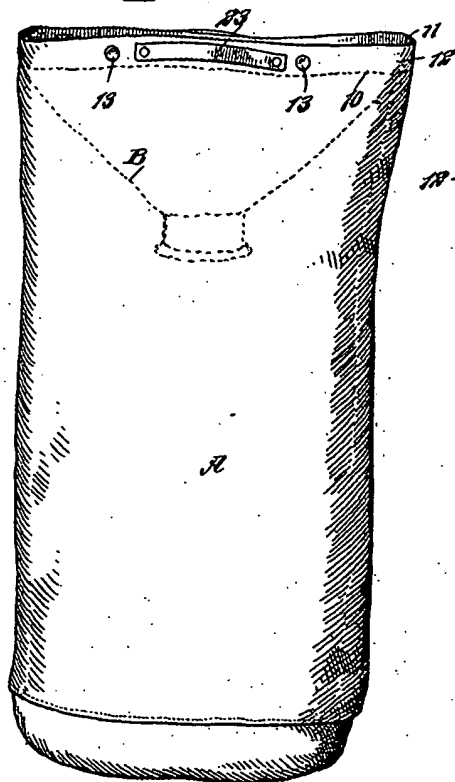


Fig. 2.

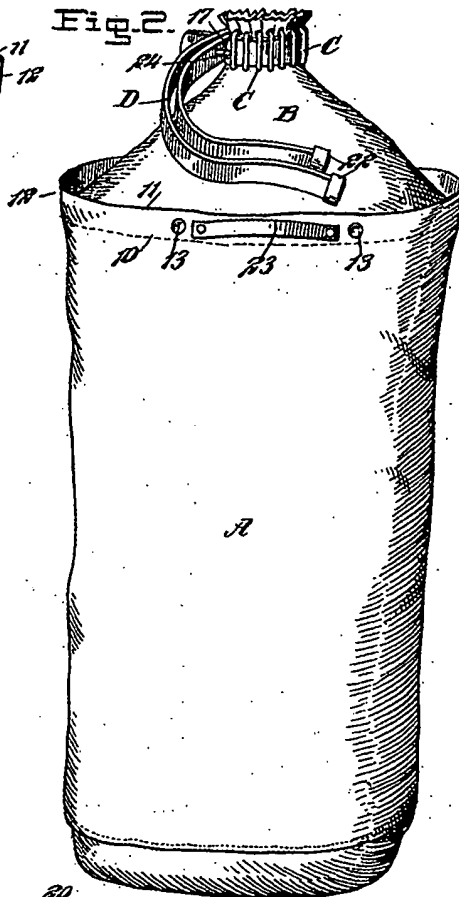


Fig. 3.

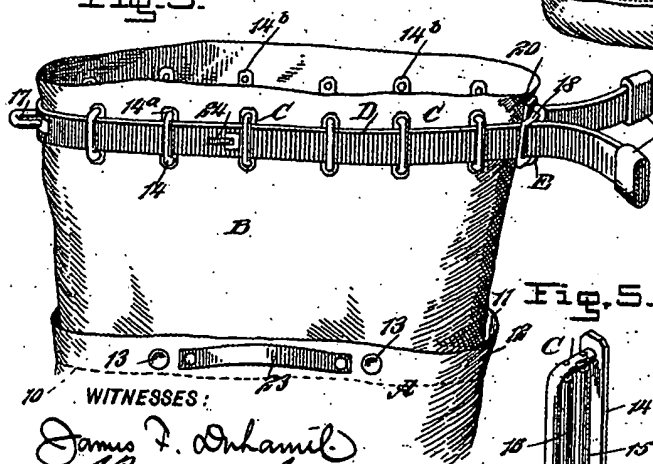


Fig. 4.

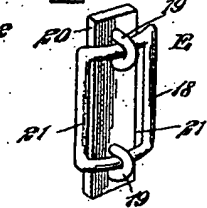
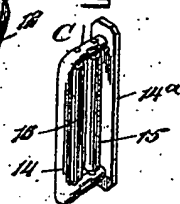


Fig. 5.



WITNESSES:

James F. Orhamil  
J. F. Orhamil

INVENTOR

Jasper N. Tabler.

BY *Munn*  
ATTORNEYS

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# UNITED STATES PATENT OFFICE.

JASPER NEWTON TABLER, OF ROYSE CITY, TEXAS.

## MAIL-POUCH.

SPECIFICATION forming part of Letters Patent No. 665,942, dated January 15, 1901.

Application filed June 8, 1900. Serial No. 19,715. (No model.)

*To all whom it may concern:*

Be it known that I, JASPER NEWTON TABLER, a citizen of the United States, and a resident of Royse City, in the county of Rock-wall and State of Texas, have invented a new and Improved Mail-Pouch, of which the following is a full, clear, and exact description.

The purpose of the invention is to provide an extension-top for mail-pouches and a simple, quickly-operated, and secure fastening device for the mouth of said extension-top, and to further so apply the extension-top to the body of the pouch that when the mouth is locked the extension-top and its fastening device will drop within the body of the bag, the top portion of which body may be held closed by auxiliary devices.

The invention consists in the novel construction and combination of the several parts, as will be hereinafter fully set forth, and pointed out in the claims.

Reference is to be had to the accompanying drawings, forming a part of this specification, in which similar characters of reference indicate corresponding parts in all the figures.

Figure 1 is a side elevation of a mail-pouch having the improvement applied, the extension-top having been locked and dropped within the body and the upper portion of the body being closed. Fig. 2 is a perspective view of the mail-pouch, the extension-top being shown as extending from the body and its mouth closed and locked. Fig. 3 is a perspective view of the upper portion of a mail-pouch and the extension-top, the latter being open and illustrating the construction of the fastening device applied to the extension-top; and Figs. 4 and 5 are detail views of guides for the strap which forms a portion of the fastening device for the mouth portion of the extension-top.

A represents the body of a mail-pouch, which is of the conventional shape and may be made of any desired material.

B represents an extension-top for the body of the pouch. This extension-top B is of a lighter material than that of the body, and the extension-top at its lower edge is attached to the inner surface of the body by stitching or otherwise at a line 10 any desired distance from the upper edge 11 of the body, thus forming a flap 12 at the top of the body, which is

free from the extension-top B. This flap 12 is provided on one side, usually, with spring-buttons 13, adapted to enter suitable sockets (not shown) and which are secured to the opposite side of the flap. A series of loop-frames C is arranged in rows at opposite sides of the extension-top B, near the mouth thereof, and these loop-frames are placed parallel with the longitudinal axis of the bag or pouch and may be placed any desired distance apart. Each loop-frame C, as shown in Fig. 5, consists of a bow-body 14, having its ends secured to a plate 14<sup>a</sup>, and this plate is attached to the outer face of the extension-top by rivets or otherwise, which rivets are usually passed through reinforcing-plates 14<sup>b</sup>, placed upon the inner surface of the extension-top, as illustrated in Fig. 3. Usually two rollers 15 and 16 are mounted to turn in the bow member 14 of each loop-frame C; but one of the rollers (the roller 16) may be omitted and a sleeve substituted, which sleeve when employed turns loosely upon the vertical member of the bow. A strap D is passed between the rollers 15 and 16 of all of the loop-frames C, and the ends of the strap extend beyond the extension-top, as is shown in Fig. 3, and at the side of the extension-top opposite that at which the staple 17 is located a guide E is secured to the extension-top. As shown in Fig. 4, this guide consists of a link 18, secured at the central portion of its top and bottom by staples 19 or their equivalents to the plate 20, and this plate is attached by rivets or other means securely to the extension portion of the bag. The link 18 is preferably curved in direction of the curvature of the bag, as is shown in Figs. 3 and 4. The side portions of the link 18 extend sufficiently beyond the sides of the plate 20 to provide openings 21, through which openings the ends of the strap D are loosely passed, and preferably enlargements 22 are formed at the extremities of the strap.

Handles 23 are usually attached to the body portion of the bag, as shown in Figs. 1, 2, and 3, and slots 24 are made in the strap D, one at each side of the extension-top and at an equal distance from the staple 17. When the extension-top is fully open, as shown in Fig. 3, the mouth of the top constitutes the mouth of the bag. When the bag is to be closed,

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the strap D is grasped by one hand at its extremities and the guide E is pressed upon by the other hand. The guide is pressed in one direction, while the strap is drawn in an opposite direction, and in this manner the material at the mouth portion of the extension-top is drawn close together in many folds, the strap passing easily through the loop-frames C. When the mouth of the extension-top has thus been completely closed, the slots 24 in the straps will be opposite each other. These slots are then made to receive the staple 17, and the hasp of a lock is thereupon passed through the staple. After the extension-top has been thus closed by its own weight it will drop down into the body of the bag, as shown in dotted lines in Fig. 1, and then the opposing sides of the flap 12 are brought together and connected by the auxiliary locking device heretofore referred to.

This form of bag protects the locking device, renders the bag easily handled, and the fastening device enables the bag to be quickly locked or unlocked, and the extension-top provides an ample opening for the reception of material.

Having thus described my invention, I claim as new and desire to secure by Letters Patent—

1. A mail pouch or bag provided with an extension-top connected with the inside of the pouch and adapted to be entirely received by the body thereof, loop-frames provided with rollers secured to the extension-top at the mouth, a strap passed between the rollers of the loop-frames, and a staple which secures the strap between its ends to the extension-top, the said strap being provided with opposing slots adapted to register and to receive said staple when the mouth of the extension of the bag is closed, as specified.

2. The combination, with a mail pouch or bag and an extension-top for the same, the extension-top being secured to the inner surface of the body of the pouch near the upper edge of said body, and a strap passed around the extension-top, the said strap being secured at its center to the top and provided

at its secured portion with a staple, of loop-frames secured to the outer surface of the extension-top, the loop-frames having rollers therein, between which rollers the said strap is passed, the strap having slots at opposite sides of the extension-top at equal distances from the staple, and a guide-link provided with a plate centrally dividing it, which plate is secured to the extension-top at a point opposite that at which the staple is located, the ends of the strap being passed through the said link at each side of the dividing-plate, for the purpose set forth.

3. The combination, with a mail pouch or bag and an extension-top for the same, the said extension-top being secured to the inner surface of the body of the pouch near the upper-edge of the said body, and a strap passed around the extension-top, the said strap being secured at its center to the top and provided at its secured portion with a staple, of loop-frames secured to the outer surface of the extension-top, the loop-frames having rollers therein, between which rollers the said strap is passed, the strap having slots at opposite sides of the extension-top at equal distances from the staple, and a guide-link provided with a plate centrally dividing it, which plate is secured to the extension-top at a point opposite that at which the staple is located, the ends of the strap being passed through the said link at each side of the dividing-plate, knobs formed at the ends of the said strap, and fastening devices located at the upper portion of the body of the bag or pouch and adapted to close the said upper portion of the body of the bag or pouch when the extension-top has been closed and passed downward into the body of the bag or pouch, as specified.

In testimony whereof I have signed my name to this specification in the presence of two subscribing witnesses.

JASPER NEWTON TABLER.

Witnesses:

E. L. STEVENSON,  
S. B. LASITER.

**(x) Related proceedings appendix**

United States Court of Appeals for the Federal Circuit in regard to 04-1152 Teleflex, Incorporated and Technology Holding Company v. KRS International, Co. 1/6/2006. This court decision will hereafter be referred to as USCAFC-0401152.

NOTE: Pursuant to Fed. Cir. R. 47.6, this disposition  
is not citable as precedent. It is a public record.

## United States Court of Appeals for the Federal Circuit

04-1152

TELEFLEX, INCORPORATED and  
TECHNOLOGY HOLDING COMPANY,

Plaintiffs-Appellants,

v.

KSR INTERNATIONAL CO.,

Defendant-Appellee.

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DECIDED: January 6, 2005

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Before MAYER,\* SCHALL, and PROST, Circuit Judges.

SCHALL, Circuit Judge.

### DECISION

Teleflex Incorporated and Technology Holding Company (collectively, "Teleflex") sued KSR International Co. ("KSR") in the United States District Court for the Eastern District of Michigan for infringement of U.S. Patent No. 6,237,565 B1 ("the '565 patent"). On December 12, 2003, the district court granted summary judgment in favor of KSR,

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Judge Haldane Robert Mayer vacated the position of Chief Judge on December 24, 2004.

after determining that claim 4 of the '565 patent, the sole claim at issue, was invalid by reason of obviousness. Teleflex Inc. v. KSR Int'l Co., 298 F. Supp. 2d 581 (E.D. Mich. 2003). Teleflex now appeals the district court's decision. For the reasons set forth below, we vacate the grant of summary judgment and remand the case to the district court for further proceedings.

## DISCUSSION

### I.

Claim 4 of the '565 patent relates to an adjustable pedal assembly<sup>1</sup> for use with automobiles having engines that are controlled electronically with a device known as an electronic throttle control. As such, the assembly of claim 4 incorporates an electronic pedal position sensor (referred to in claim 4, and throughout this opinion, as an "electronic control"). The electronic control is responsive to the pedal pivot and thereby generates an electrical signal corresponding to the relative position of the gas pedal between the rest and applied positions. Claim 4 specifically provides for an assembly wherein the electronic control is mounted to the support bracket of the assembly. This configuration avoids movement of the electronic control during adjustment of the pedal's position on the assembly. Claim 4 reads:

A vehicle control pedal apparatus (12) comprising:

a support (18) adapted to be mounted to a vehicle structure (20);

an adjustable pedal assembly (22) having a pedal arm (14) moveable in force [sic] and aft directions with respect to said support (18);

---

<sup>1</sup> An adjustable pedal assembly (e.g., gas, break, or clutch) allows the location of the pedal to be adjusted to accommodate a particular driver's height.

a pivot (24) for pivotally supporting said adjustable pedal assembly (22) with respect to said support (18) and defining a pivot axis (26); and

an electronic control (28) attached to said support (18) for controlling a vehicle system;

said apparatus (12) characterized by said electronic control (28) being responsive to said pivot (24) for providing a signal (32) that corresponds to pedal arm position as said pedal arm (14) pivots about said pivot axis (26) between rest and applied positions wherein the position of said pivot (24) remains constant while said pedal arm (14) moves in fore and aft directions with respect to said pivot (24).

The numbers in claim 4 correspond to the numbers in Figure 2 of the '565 patent.

The specification of the '565 patent indicates that prior-art pedal assemblies incorporating an electronic control suffered from being too bulky, complex, and expensive to manufacture. See '565 patent, col. 1, ll. 48-53. It was this problem that the '565 patent set out to address. See id. col. 2, ll. 2-5.

Teleflex sued KSR in the Eastern District of Michigan, alleging that KSR's adjustable pedal assembly infringed claim 4 of the '565 patent. KSR moved for summary judgment of invalidity of claim 4 based on obviousness under 35 U.S.C. § 103. The district court granted KSR's motion after determining that claim 4 was obvious in view of a combination of prior art references. Teleflex timely appealed the district court's decision. We have jurisdiction pursuant to 28 U.S.C. § 1295(a)(1).

## II.

This court reviews a district court's grant of summary judgment de novo. TorPharm Inc. v. Ranbaxy Pharms., Inc., 336 F.3d 1322, 1326 (Fed. Cir. 2003). "In a patent case, as in any other, summary judgment may be granted when there are no

disputed issues of material fact, . . . or when the non-movant cannot prevail on the evidence submitted when viewed in a light most favorable to it.” Knoll Pharm. Co. v. Teva Pharms. USA, Inc., 367 F.3d 1381, 1383 (Fed. Cir. 2004). The movant carries the initial burden of proving that there are no genuine issues of material fact. Celotex Corp. v. Catrett, 477 U.S. 317, 322-24, 106 S. Ct. 2548, 91 L. Ed. 2d 265 (1986). If the movant shows a prima facie case for summary judgment, then the burden of production shifts to the nonmovant to present specific evidence indicating there is a genuine issue for trial. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 250, 106 S. Ct. 2505, 91 L. Ed. 2d 202 (1986). “When ruling on a motion for summary judgment, all of the nonmovant’s evidence is to be credited, and all justifiable inferences are to be drawn in the nonmovant’s favor.” Caterpillar Inc. v. Deere & Co., 224 F.3d 1374, 1379 (Fed. Cir. 2000). “Where the evidence is conflicting or credibility determinations are required, the judgment should be vacated rather than reversed, and the case should be remanded for further proceedings.” Jones v. Hardy, 727 F.2d 1524, 1531 (Fed. Cir. 1984).

“The grant of summary judgment of invalidity for obviousness must be done on a claim by claim basis.” Knoll Pharm., 367 F.3d at 1383. Because patents are presumed valid, “[t]he accused infringer must prove by clear and convincing evidence that each claim that is challenged cannot reasonably be held to be non-obvious.” Id.; see also Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, 139 F.3d 877, 881 (Fed. Cir. 1998). Clear and convincing evidence exists when the movant “place[s] in the mind of the ultimate fact finder an abiding conviction that the truth of its factual contentions are ‘highly probable.’” Colorado v. New Mexico, 467 U.S. 310, 316, 104 S. Ct. 2433, 81 L. Ed. 2d 247 (1994).



A patent claim is obvious, and thus invalid, when the differences between the claimed invention and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103; see also Graham v. John Deere Co., 383 U.S. 1, 14, 86 S. Ct. 684, 15 L. Ed. 2d 545 (1966); In re Dembiczak, 175 F.3d 994, 998 (Fed. Cir. 1999). While obviousness is ultimately a legal determination, it is based on several underlying issues of fact, namely: (1) the scope and content of the prior art; (2) the level of skill of a person of ordinary skill in the art; (3) the differences between the claimed invention and the teachings of the prior art; and (4) the extent of any objective indicia of non-obviousness. See Graham, 383 U.S. at 17-18. When obviousness is based on the teachings of multiple prior art references, the movant must also establish some "suggestion, teaching, or motivation" that would have led a person of ordinary skill in the art to combine the relevant prior art teachings in the manner claimed. See Tec Air, Inc. v. Denso Mfg. Mich. Inc., 192 F.3d 1353, 1359-60 (Fed. Cir. 1999); Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1572 (Fed. Cir. 1996). The nonmovant may rebut a prima facie showing of obviousness with evidence refuting the movant's case or with other objective evidence of nonobviousness. See WMS Gaming, Inc. v. Int'l Game Tech., 184 F.3d 1339, 1359 (Fed. Cir. 1999).

"The reason, suggestion, or motivation to combine [prior art references] may be found explicitly or implicitly: 1) in the prior art references themselves; 2) in the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, 'leading inventors to look to references relating to possible

solutions to that problem.” Ruiz v. A.B. Chance Co., 234 F.3d 654, 665 (Fed. Cir. 2000) (quoting Pro-Mold, 75 F.3d at 1572). “Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” Dembiczak, 175 F.3d at 999; see also Ruiz, 234 F.3d at 665 (explaining that the temptation to engage in impermissible hindsight is especially strong with seemingly simple mechanical inventions). This is because “[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.” Dembiczak, 175 F.3d at 999. Therefore, we have consistently held that a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but some motivation to combine the prior art teachings in the particular manner claimed. See, e.g., In re Kotzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000) (“Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” (emphasis added)); In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (“In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” (emphasis added)).

### III.

On appeal, Teleflex argues that we should vacate the district court's grant of summary judgment and remand the case because the district court committed multiple errors in its obviousness determination. First, Teleflex urges that the district court erred as a matter of law by combining prior art references based on an incorrect teaching-suggestion-motivation test. Second, it contends that genuine issues of material fact still remain as to whether a person of ordinary skill in the art would have considered it obvious to combine prior art in the manner stated in claim 4. Finally, Teleflex argues that the district court erred by not properly considering the commercial success of Teleflex's patented assembly and by failing to give adequate deference to the patentability determination of the U.S. Patent and Trademark Office ("PTO").

KSR responds that the district court did apply the correct teaching-suggestion-motivation test, and that, under that test, the court correctly concluded that no genuine issues of material fact existed so as to prevent the grant of summary judgment. KSR contends that the district court properly discounted the declarations of Teleflex's experts because their opinions were based on mere legal conclusions. KSR also contends that the district court properly dismissed Teleflex's evidence of commercial success because Teleflex failed to establish a nexus between commercial success and the claimed invention. Finally, KSR argues that the district court gave proper deference to the PTO.

We agree with Teleflex that the district court did not apply the correct teaching-suggestion-motivation test. We also agree that, under that test, genuine issues of material fact exist, so as to render summary judgment of obviousness improper. For

these reasons, we vacate the decision of the district court and remand for further proceedings consistent with this opinion.

#### IV.

After comparing the teachings of the prior art with claim 4 of the '565 patent, the district court concluded that, at the time of the invention, all of the limitations of claim 4 existed in the prior art. The court explained that U.S. Patent No. 5,010,782, issued to Asano et al. ("the Asano patent"), disclosed all of the structural limitations of claim 4 with the exception of the electronic control. Teleflex, 298 F. Supp. 2d at 592 ("Asano teaches an adjustable pedal assembly pivotally mounted on a support bracket with the pedal moving in a fore and aft directions with respect to the support and the pivot remaining in a constant position during movement of the pedal arm."). Electronic controls were well known in the prior art. Id. Consequently, after finding a person of ordinary skill in the art would have been motivated to combine Asano and electronic control references, the district court granted KSR's motion for summary judgment of invalidity by reason of obviousness.

The district court based its finding of a suggestion or motivation to combine largely on the nature of the problem to be solved by claim 4 of the '565 patent. Id. at 593-94. The court determined from the patent's specification that the invention of the '565 patent was intended to "solve the problem of designing a less expensive, less complex and more compact [assembly] design." Id. at 593. The court then explained that U.S. Patent No. 5,819,593, issued to Rixon et al. ("the Rixon '593 patent"),<sup>2</sup> also

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<sup>2</sup> As explained by the district court, the Rixon '593 patent teaches the combination of an electronic control with an adjustable pedal assembly. The Rixon '593 patent and claim 4 differ, however, in that the electronic control of Rixon is attached to

“suffered from being too complex because the pedal position sensor is located in the pedal housing and its fore and aft movement with the adjustment of the pedal could cause problems with wire failure. Thus, the solution to the problem required an electronic control that does not move with the pedal arm while the pedal arm is being adjusted by the driver.” Id. at 594. The court then concluded that “a person with ordinary skill in the art with full knowledge of Asano and the modular pedal position sensors would be motivated to combine the two references to avoid the problems with Rixon '593.” Id.

The district court also found an express teaching to attach the electronic control to the support bracket of a pedal assembly based on the disclosure of U.S. Patent No. 5,063,811, issued to Smith et al. (“the Smith patent”). The court explained that Smith teaches the use of a “rotary potentiometer . . . attached to a fixed support member and responsive to the pedal's pivot shaft.” Id. Moreover, the court stated that Smith provided express teachings as to the desirability of attaching the electronic control to a fixed support member in order to avoid the wire failure problems disclosed in the Rixon '593 patent and solved by the '565 patent: “[T]he wiring to the electrical components must be secure from the possibility of chafing which will eventually result in electrical failure. Thus, the pedal assemblies must not precipitate any motion in the connecting wires themselves . . . .” Id. (quoting the Smith patent, col. 1, ll. 33-38).

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(Cont'd. . . .)

the pedal housing instead of the support bracket. See Teleflex, 298 F. Supp. 2d at 594. The electronic control of the Rixon reference consequently moves during adjustment of the pedal assembly. Id. The electronic control of claim 4 does not move during adjustment of the pedal assembly.

Finally, the district court explained that the prosecution history of the '565 patent bolstered its finding of a suggestion or motivation to combine the Asano and electronic control references. The court explained that the patent examiner initially rejected the '565 patent in view of the teachings of U.S. Patent No. 5,460,061, issued to Redding et al. ("the Redding patent"), and the Smith patent. The examiner stated that the Redding patent disclosed the assembly structure of claim 4 and that Smith disclosed the electronic control attached to the assembly support structure. The patentee overcame the rejection, the court explained, by adding the limitation requiring the position of the assembly's pedal pivot to remain constant during adjustment of the assembly. (The position of the pedal pivot of the Redding patent does not remain constant during adjustment of the assembly position.) However, the Asano patent discloses an assembly where the position of the pivot remains constant during adjustment of the pedal assembly. Therefore, the district court reasoned, had Asano been cited to the patent examiner, the examiner would have rejected claim 4 as obvious in view of the Asano and Smith patents. Id. at 595.

We agree with Teleflex that the district court's analysis applied an incomplete teaching-suggestion-motivation test in granting KSR summary judgment. This is because the district court invalidated claim 4 of the '565 patent on obviousness grounds without making "finding[s] as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of [the] invention to make the combination in the manner claimed." Kotzab, 217 F.3d at 1371. Under our case law, whether based on the nature of the problem to be solved, the express teachings of the prior art, or the knowledge of one of ordinary skill in the art, the

district court was required to make specific findings as to whether there was a suggestion or motivation to combine the teachings of Asano with an electronic control in the particular manner claimed by claim 4 of the '565 patent. See Kotzab, 217 F.3d at 1371; Rouffet, 149 F.3d at 1357. That is, the district court was required to make specific findings as to a suggestion or motivation to attach an electronic control to the support bracket of the Asano assembly.

The district court correctly noted that the nature of the problem to be solved may, under appropriate circumstances, provide a suggestion or motivation to combine prior art references. However, the test requires that the nature of the problem to be solved be such that it would have led a person of ordinary skill in the art to combine the prior art teachings in the particular manner claimed. See Rouffet, 149 F.3d at 1357. We have recognized this situation when two prior art references address the precise problem that the patentee was trying to solve. See Ruiz, 357 F.3d at 1276 ("This record shows that the district court did not use hindsight in its obviousness analysis, but properly found a motivation to combine because the two references address precisely the same problem of underpinning existing structural foundations."). In this case, the Asano patent does not address the same problem as the '565 patent. The objective of the '565 patent was to design a smaller, less complex, and less expensive electronic pedal assembly. The Asano patent, on the other hand, was directed at solving the "constant ratio problem."<sup>3</sup> The district court's reliance on the problems associated with the Rixon '593 patent similarly fails to provide a sufficient motivation to combine. This is

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<sup>3</sup> The constant ratio problem refers to the problem of creating an assembly where the force required to depress the pedal remains constant irrespective of the position of the pedal on the assembly. See Asano patent, col. 1, l. 48–col. 2, l. 13.

because the Rixon '593 patent does not address the problem to be solved by the '595 patent; rather, it suffers from the problem. The court did not explain how suffering from the problem addressed by the '595 patent would have specifically motivated one skilled in the art to attach an electronic control to the support bracket of the Asano assembly.

Neither do we agree with the district court's reliance on the express teachings of the Smith patent. This is because the statement in the Smith patent that "the pedal assemblies must not precipitate any motion in the connecting wires," does not necessarily go to the issue of motivation to attach the electronic control on the support bracket of the pedal assembly. In other words, solving the problem of wire chafing is a different task than reducing the complexity and size of pedal assemblies. What is more, the Smith patent does not relate to adjustable pedal assemblies; therefore, it does not address the problem of wire chafing in an adjustable pedal assembly.

Our view of the case is not altered by the '565 patent's prosecution history. That is because a court's task is not to speculate as to what an examiner might have done if confronted with a piece of prior art. Rather, a court must make an independent obviousness determination, taking into account the statutory presumption of patent validity. See TorPharm, 336 F.3d at 1329-30 ("[W]here the factual bases of an examiner's decision to allow a claim have been undermined—as in other cases where prior art not before the examiner is brought to light during litigation—a court's responsibility is not to speculate what a particular examiner would or would not have done in light of the new information, but rather to assess independently the validity of



the claim against the prior art under section 102 or section 103. Such determination must take into account the statutory presumption of patent validity.”).<sup>4</sup>

We also agree with Teleflex that the presence of genuine issues of material fact rendered summary judgment inappropriate. KSR, in the first instance, failed to make out a prima facie case of obviousness. The only declaration offered by KSR—a declaration by its Vice President of Design Engineering, Larry Willemssen—did not go to the ultimate issue of motivation to combine prior art, i.e. whether one of ordinary skill in the art would have been motivated to attach an electronic control to the support bracket of the assembly disclosed by Asano. Mr. Willemssen did state that an electronic control “could have been” mounted on the support bracket of a pedal assembly. (Willemssen Decl. at ¶ 33, 36, 39.) Such testimony is not sufficient to support a finding of obviousness, however. See, e.g., In re Deuel, 51 F.3d 1552, 1559 (Fed. Cir. 1995) (“‘Obvious to try’ has long been held not to constitute obviousness.”). Mr. Willemssen also provided the following as a “specific motivation to combine” an electronic control with an adjustable pedal assembly:

[A]n increasing number of vehicles sold in the United States came equipped with electronic throttle control systems because such systems offered various operational advantages over cable-actuated throttle control systems . . . . In order to function in a vehicle whose engine incorporated an electronic throttle control, the adjustable pedal assembly . . . would have had to be coupled to an electronic pedal position sensor.

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<sup>4</sup> Noting Teleflex’s argument that the district court did not give adequate deference to the PTO, we do not discern anything in the record indicating the district court failed to properly defer to the PTO. Nevertheless, we reiterate that, on remand, the district court must independently assess the evidence and determine whether KSR has provided clear and convincing evidence indicating invalidity of claim 4 by reason of obviousness.

(Willemsen Decl. at ¶¶ 34, 37, 39.) This statement may be factually correct. However, the issue is not whether a person of skill in the art had a motivation to combine the electronic control with an adjustable pedal assembly, but whether a person skilled in the art had a motivation to attach the electronic control to the support bracket of the pedal assembly.

In addition, Teleflex offered two declarants—Clark J. Radcliffe, Professor of Mechanical Engineering at Michigan State University; and Timothy L. Andresen, a former engineer at Ford Motor Company and McDonnell-Douglas Corporation—in rebuttal of the declaration of Mr. Willemsen. Mr. Radcliffe stated, *inter alia*, that “[t]he location of the electronic control” (Radcliffe Decl. at ¶ 15) in claim 4 “was a simple, elegant, and novel combination of features,” (Radcliffe Decl. at ¶ 16) as opposed to the Rixon '593 patent’s attachment of the electronic control to the assembly housing, which was both electrically and mechanically complex (Radcliffe Decl. at ¶ 17). Mr. Andresen also stated that the non-obviousness of claim 4 was reflected in Rixon’s choice to mount the electronic control to the assembly housing instead of the assembly’s support bracket. (Andresen Decl. at ¶ 5.) At the summary judgment stage of a proceeding, it is improper for a district court to make credibility determinations. *See, e.g., Jones*, 727 F.2d at 1531. Therefore, by crediting KSR’s expert declarant and discrediting the two declarants offered by Teleflex, the district court erred as a matter of law.

V.

In sum,

(1) We hold that, in granting summary judgment in favor of KSR, the district court erred as a matter of law by applying an incomplete teaching-suggestion-motivation

test to its obviousness determination. The correct standard requires a court to make specific findings showing a teaching, suggestion, or motivation to combine prior art teachings in the particular manner claimed by the patent at issue.

(2) Under this standard, we hold that genuine issues of material fact exist as to whether a person of ordinary skill in the art would have been motivated, at the time the invention was made, to attach an electronic control to the support structure of the pedal assembly disclosed by the Asano patent.

(3) We consequently vacate the decision of the district court and remand the case for further proceedings on the issue of obviousness, and, if necessary, proceedings on the issues of infringement and damages.

Each party shall bear its own costs.